

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|----------------------------------|---|-------------------------|
| -----X | : | |
| GALLEON S.A. | : | |
| BACARDI-MARTINI U.S.A., INC. and | : | |
| BACARDI & COMPANY LIMITED, | : | Cancellation No. 24,108 |
| | : | |
| <i>Petitioners,</i> | : | |
| | : | |
| -against- | : | |
| | : | |
| HAVANA CLUB HOLDING, S.A. and | : | |
| EMPRESA CUBANA EXPORTADOR | : | |
| DE ALIMENTOS Y PRODUCTOS | : | |
| VARIOS, S.A., d.b.a. CUBAEXPORT, | : | |
| | : | |
| <i>Respondents</i> | : | |
| | : | |
| -----X | : | |

DECLARATION OF CHARLES SIMS

CHARLES SIMS declares under penalty of perjury:

1. I am a member of the firm of Proskauer Rose LLP, counsel for Havana Club Holding, S.A. (HCH) in the above-captioned cancellation proceeding. I submit this affirmation in support of HCH's Motion Of Respondent Havana Club Holding, S.A. For Reconsideration Of The Board's Decision Dated January 21, 2003. I have personal knowledge of the matters set forth below.
2. Annexed hereto as Exhibit A are true and correct copies of documents obtained by HCH after submission of its motion for relief under the Government in the Sunshine Act, relevant to that motion.
 - a. Pages numbered FOIA 0001 through 0129 represent documents obtained by Ryan Banfill, Communications Director for the Florida Democratic Party,

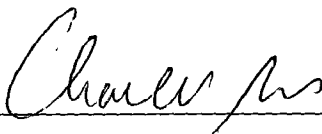
from the Office of Governor Jeb Bush of Florida, pursuant to a request under to the Florida Public Records Act, Fla. Stat. ch. 119.01 et seq.

b. Pages numbered FOIA 0130-0146 represent documents obtained by Mr. Thomas Edsall, a reporter for The Washington Post, pursuant to a request to the United States Patent and Trademark Office under the Freedom of Information Act, 5 U.S.C. §552.

HCH obtained these documents from Messrs. Banfill and Edsall upon request, after HCH learned that those individuals had obtained the documents. HCH did not have or know of these documents until after submission of its motion for relief under the Government in the Sunshine Act.

3. Annexed hereto as Exhibit B is a chronology of events prepared under my supervision and control, summarizing passages from or events mentioned in the documents comprising Exhibit A and those previously submitted on the motion. References to *ex parte* communications are underlined. All dates and quotations are cited to the documents annexed in Exhibits A.

I declare under penalty of perjury that the foregoing is true and correct. Executed on February 18, 2003.

A handwritten signature in cursive script, appearing to read "Charles S. Sims", is written over a horizontal line.

Charles S. Sims

EXHIBIT A



JEB BUSH
GOVERNOR

STATE OF FLORIDA

Office of the Governor

THE CAPITOL
TALLAHASSEE, FLORIDA 32399-0001

www.flgov.com
850-488-7146
850-487-0801 fax

June 13, 2002

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Under Secretary Rogan:

I am writing on behalf of Florida-based Bacardi-Martini, USA, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini, USA, Inc. generates close to \$1 billion of business a year nationally. The company's domestic headquarters are located in Miami and has a workforce of more than 300 Floridians and more than 600 employees throughout the United States.

As I understand, since 1997 Bacardi-Martini, USA, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration of the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family who owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by Castro's Cuban government and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini, USA, Inc. purchased the Havana Club brand and assets in 1997 from the original owners.

Though Bacardi-Martini, USA, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.



Governor's Mentoring Initiative

FOIA 0001

JUL-12-2002 09:20

P.02



UNITED STATES
PATENT AND
TRADEMARK OFFICE

COS
cc: CLUB
GOV

Under Secretary of Commerce For Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.uspto.gov

JUL - 3 2002

The Honorable Jeb Bush
Governor of Florida
Tallahassee, Florida 32399-0001

#383136 Rogan, James
Recd: 07/11/2002 DEO: LAB
To: COS-W/A-
PLEASE HANDLE
Due: 07/25/2002

Dear Governor Bush: *Jeb -*

Thank you very much for your letter of June 13, 2002, regarding the trademark "HAVANA CLUB". I am grateful for the opportunity to provide you with specific information regarding the status of the "HAVANA CLUB" trademark registration.

U.S. Trademark Registration No. 1,031,651 ("HAVANA CLUB" and design) is the subject of Cancellation Proceeding No. 92-024108 before the United States Patent and Trademark Office's (USPTO) Trademark Trial and Appeal Board (TTAB).

The cancellation proceeding was initiated in 1995 by Galleon S.A., Bacardi-Martini U.S.A., Inc., and Bacardi & Company Ltd. ("Bacardi") against Havana Club Holding, S.A. and Havana Rum & Liquors, S.A., d/b/a/ H.R.L., S.A. ("HCH"). At the request of the parties, the proceeding was suspended on July 1, 1999, pending the outcome of other civil litigation. The proceeding was revived, again at the request of the parties, earlier this year.

On January 15, 2002, pursuant to an October 20, 1997 Court order from the United States District Court for the Southern District of New York, the USPTO's Commissioner for Trademarks ordered USPTO assignment and registration records rectified to reflect ownership of U.S. Trademark Registration No. 1,031,651 in Cubaexport. The assignment changes were recorded in the USPTO's records at: Reel: 002398 Frames: 0855-0863.

On March 15, 2002, Bacardi filed a petition to substitute Cubaexport as the defendant in the cancellation proceeding and to obtain summary judgment (for cancellation). On March 19, 2002, Bacardi filed with the U.S. Court of Appeals for the Federal Circuit a petition for review of the Commissioner for Trademarks' January 15, 2002 order. *Galleon, S.A. v. Chasser*, No. 02-1289 (Fed. Cir.). On May 13, 2002, the TTAB suspended action on the cancellation proceeding pending the outcome of the relevant litigation (*Galleon, S.A. v. Chasser*, No. 02-1289) in the U.S. Court of Appeals for the Federal Circuit.

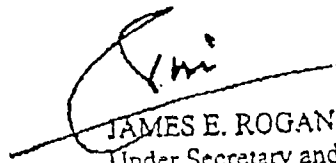
FOIA 0002

-2-


I hope this information clarifies the status of the cancellation proceeding involving the "HAVANA CLUB" case. To an important degree, the parties themselves are determining the pace of final resolution with respect to Cancellation Proceeding No. 92-024108. The Office will act expeditiously when the proceeding reaches the stage where the TTAB has statutory and regulatory authority to render a final decision.

Thank you again for this opportunity to provide an update regarding the status of Cancellation Proceeding No. 92-024108. If you should have any questions about this matter, please call me or Jon Dudas, Deputy Under Secretary for Intellectual Property, at (703) 305-8700.

Sincerely,


JAMES E. ROGAN
Under Secretary and Director

*Please pass along my
affectionate regards to two
old friends: Kathleen
Shanahan & Charles Canady!*





JES BUSH
GOVERNOR

STATE OF FLORIDA

Office of the Governor

THE CAPITOL
TALLAHASSEE, FLORIDA 32399-0001

www.flgov.com
850.455.7146
850.457.0391 fax

June 13, 2002

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Under Secretary Rogan:

I am writing on behalf of Florida-based Bacardi-Martini, USA, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini, USA, Inc. generates close to \$1 billion of business a year nationally. The company's domestic headquarters are located in Miami and has a workforce of more than 300 Floridians and more than 600 employees throughout the United States.

As I understand, since 1997 Bacardi-Martini, USA, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration of the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family who owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by Castro's Cuban government and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini, USA, Inc. purchased the Havana Club brand and assets in 1997 from the original owners.

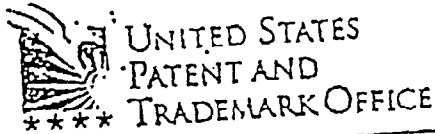
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FOIA 0004



Governor's Mentoring Initiative
BE A MENTOR. BE A BIG HELP.
1-800-123-3716

Exhibit D



Under Secretary of Commerce For Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.uspto.gov

JUL - 3 2002

The Honorable Jeb Bush
Governor of Florida
Tallahassee, Florida 32399-0001

Dear Governor Bush: *Jeb*

Thank you very much for your letter of June 13, 2002, regarding the trademark "HAVANA CLUB". I am grateful for the opportunity to provide you with specific information regarding the status of the "HAVANA CLUB" trademark registration.

U.S. Trademark Registration No. 1,031,651 ("HAVANA CLUB" and design) is the subject of Cancellation Proceeding No. 92-024103 before the United States Patent and Trademark Office's (USPTO) Trademark Trial and Appeal Board (TTAB).

The cancellation proceeding was initiated in 1995 by Galleon S.A., Bacardi-Martini U.S.A., Inc., and Bacardi & Company Ltd. ("Bacardi") against Havana Club Holding, S.A. and Havana Rum & Liquors, S.A., d/b/a/ H.R.L., S.A. ("HCH"). At the request of the parties, the proceeding was suspended on July 1, 1999, pending the outcome of other civil litigation. The proceeding was revived, again at the request of the parties, earlier this year.

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On March 15, 2002, Bacardi filed a petition to substitute Cubaexport as the defendant in the cancellation proceeding and to obtain summary judgment (for cancellation). On March 19, 2002, Bacardi filed with the U.S. Court of Appeals for the Federal Circuit a petition for review of the Commissioner for Trademarks' January 15, 2002 order. *Galleon, S.A. v. Chasser*, No. 02-1289 (Fed. Cir.). On May 13, 2002, the TTAB suspended action on the cancellation proceeding pending the outcome of the relevant litigation (*Galleon, S.A. v. Chasser*, No. 02-1289) in the U.S. Court of Appeals for the Federal Circuit.

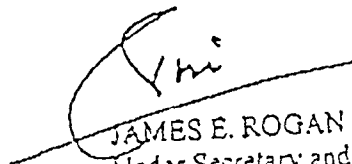
FOIA 0005

Exhibit D

I hope this information clarifies the status of the cancellation proceeding involving the "HAVANA CLUB" case. To an important degree, the parties themselves are determining the pace of final resolution with respect to Cancellation Proceeding No. 92-024108. The Office will act expeditiously when the proceeding reaches the stage where the TTAB has statutory and regulatory authority to render a final decision.

Thank you again for this opportunity to provide an update regarding the status of Cancellation Proceeding No. 92-024108. If you should have any questions about this matter, please call me or Jon Dudas, Deputy Under Secretary for Intellectual Property, at (703) 305-8700.

Sincerely,


JAMES E. ROGAN
Under Secretary and Director

*Please pass along my
affectionate regards to two
old friends: Kathleen
Shimada & Charles Candy!*



PROSKAUER ROSE LLP

1535 Broadway
New York, NY 10036-5159
Telephone 212.559.2500
Fax 212.559.2500

LOS ANGELES
WASHINGTON
BOCA RATON
NEWARK
PARIS

Gregg Reed
Attorney at Law

Direct Dial 212.559.3933
greed@proskauer.com

July 15, 2002

BY FEDERAL EXPRESS & FAX

The Governor's Office
The Capitol Building
Tallahassee, FL 32399-0001

Re: Public Records Act Request

To Whom It May Concern:

In accordance with the Public Records Act, Chapter 119 of the Florida Statutes, I hereby request the following documents:

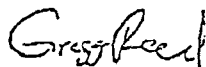
All correspondence concerning any request to cancel U.S. trademark registration No. 1,031,651 (for the mark HAYANA CLUB & Design) which was sent or received by or on behalf of Governor Jeb Bush.

If you refuse to provide this information, Chapter 119 requires you to advise me in writing and indicate the applicable exemption to the Public Records Act. Also, please state with particularity the reasons for your decision, as required by Section 119.07(2)(a). If the exemption you are claiming only applies to a portion of the records requested, please delete that portion and provide photocopies of the remainder of the records, according to Section 119.07(2)(a).

If you have any questions or need more information in order to expedite this request, please call me.

Thank you.

Sincerely,



Gregg Reed

FOIA 0007



JEB BUSH
GOVERNOR

STATE OF FLORIDA

Office of the Governor

THE CAPITOL
TALLAHASSEE, FLORIDA 32399-0001

www.flgov.com
850-433-7143
850-437-0901 fax

Total Pages

4

FAX COVER SHEET

Date: 8/28/02

To: Greg Reid

Phone: _____

Fax: 212-969-2900

From: Office of the General Counsel Room 209, The Capitol
(850) 488-3494 Phone (850) 488-9810 Fax
(850) 922-0309 Fax

| | |
|---|--|
| Charles T. Canady, General Counsel | Carlos Muniz, Deputy General Counsel |
| Leslie Jacobs, Executive Assistant | Simone Marsteller, Asst. General Counsel |
| | Susan Rehwinkel, Executive Assistant |
| X Jean Hartman, Asst. General Counsel | |
| Kevin Tang, Asst. General Counsel | Wendy Berger, Asst. General Counsel |
| Janis Maloney, Administrative Assistant | Greg Munson, Asst. General Counsel |
| | Nancy Downing, Administrative Assistant |
| Keisha Muirhead, Administrative Assistant- Receptionist | |
| | |
| Tena Pate, Victims' Rights Coordinator | Susan Smith, Extradition Coordinator |
| | |

Comments: _____

FOIA 0008

Please call our office immediately if there is a problem with the transmission.

Exhibit F



JEB BUSH
GOVERNOR

STATE OF FLORIDA

Office of the Governor

THE CAPITOL
TALLAHASSEE, FLORIDA 32399-0001

www.flgov.com
850-433-7145
850-437-0301 fax

June 13, 2002

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Under Secretary Rogan:

I am writing on behalf of Florida-based Bacardi-Martini, USA, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini, USA, Inc. generates close to \$1 billion of business a year nationally. The company's domestic headquarters are located in Miami and has a workforce of more than 300 Floridians and more than 600 employees throughout the United States.

As I understand, since 1997 Bacardi-Martini, USA, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration of the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family who owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by Castro's Cuban government and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini, USA, Inc. purchased the Havana Club brand and assets in 1997 from the original owners.

Though Bacardi-Martini, USA, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.

FOIA 0009

Exhibit F

The Honorable James E. Rogan
June 13, 2002
Page Two

A swift resolution to this matter is imperative. Should you have further questions, please do not hesitate to contact my office. You may also feel free to contact my Washington, D.C., Office at 202/624-5885. Thank you for your consideration of this matter.

Sincerely,



Jeb Bush

FOIA 0010

Exhibit F

1011 P.M.



JEB BUSH
GOV22.N03

STATE OF FLORIDA

Office of the Governor

THE CAPITOL
TALLAHASSEE, FLORIDA 32399-0001

www.flgov.com
850-433-7145
850-437-0201 fax

July 16, 2002

The Honorable James E. Rogan
Undersecretary and Director
U.S. Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Mr. Rogan:

Thank you for the information you passed along regarding the Bacardi case. Your candor on the issue is appreciated. Along with the continued assistance of Mr. Jon Dudas, your attention to this matter has been very helpful. Please do not hesitate to call upon me, if I can be of service to you in the future.

Sincerely,

A handwritten signature in dark ink, appearing to read "Jeb Bush".

Jeb Bush

FOIA 0011

Exhibit F

FEB-01-2002 09:35

EXECUTIVE OFC OF GOVERNOR

652 922 4292 P.02

Kathleen Shanahan

Bruce Slager

From: Jeb Bush [jeb@jeb.org]
Sent: Wednesday, January 09, 2002 7:53 PM
To: Kathleen Shanahan (E-mail); Ariana Dibenigno (E-mail)
Subject: FW: BACARDI NEEDS HELP

Nina 2/1/02

for our discussion.

Jeb Bush

Please note: Florida has a very broad public records law. Most written communications to or from state officials regarding state business are public records available to the public and media upon request. Your e-mail communications may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Tuesday, January 08, 2002 9:16 PM
To: Jeb Bush
Subject: BACARDI NEEDS HELP
Importance: High

Dear Jeb,

As you know Castro in partnership with Pernod, a French company, has been fighting Bacardi since 1996 over the Havana Club brand rights inside the US. Bacardi prevailed in Federal Court regarding the dispute. We also prevailed in Federal Appellate Court, and then the US Supreme Court refused to review the case.

The aggressors, unsatisfied with the end results, created an international dispute between the European Union and the US over a US law (Section 211) which they blamed for their repeated defeats in US courts. The EU filed a complaint at WTO against the US law. Last week the WTO ruled in favor of the US and Bacardi. This law prohibits recognizing rights in the US to any illegally confiscated trademarks in Cuba.

This should be the end of the line for Castro and Pernod on this issue. However, since 1997 there are two very relevant and significant issues which are still unresolved and are damaging to Bacardi.

ISSUE #1

The US Treasury Department's Office of Foreign Asset Control (OFAC) has been holding a pending license application from Havana Club Holdings (Castro-Pernod) which could grant them some rights to the HC brand. If that license is granted it will be contradicting current US law, plus it will be

defying the Federal Court rulings. We have worked with OFAC and with Under Secretary of State Alan Larson for over three years to have this pending license application denied but to

FOIA 0012

FEB-01-2002 09:36

EXECUTIVE DFC OF GOVERNOR

850 922 4232 P.03

no
avail.

ISSUE #2

The US Department of Commerce's Patent and Trademark Office (PTO) has in hand since 1997 a Federal Court Mandate instructing them to erase from their records the Havana Club Holdings (Castro and Fernod) registration to the Havana Club brand. Because of the multiple appeals PTO withheld action. But since the US Supreme Court decision in October of 2000 (15 months ago), they have found every excuse not to act on that court mandate. We have been working with PTO and also with Alan Larson on this issue too, but so far, nothing.

We need your help. Perhaps we should meet with Secretary O'Neil and Secretary Evans, or whomever you think might be helpful. I have mentioned this case to Kelley McCullough from Karl Rove's office last December 8th when they visited Miami and have sent her briefings. Al Cardenas also knows of our needs and has talk to some people.

I hope you can help us. We are asking that current laws be respected (issue #1) and that a Federal Court order is complied with (issue #2). Thanks for your time, I am sure you don't have much available. Best regards,

Jorge

Mr. Dulles--

- find out about any lawyers have not taken orders.
- Court must say Cuba Export
-Contested Litigation
- transfer legitimately due to OFAC
-OFAC
- application submitted in Cuba
-not proper manner
-need to demonstrate a conciliation
- should be a landmark case

FOIA 0013

FEB-21-2002 09:33

EXECUTIVE OFC OF GOVERNOR

650 922 4292 P.01

| |
|---|
| 188 |
| email from Governor to Kathleen/Ariano dated 1/9/02 (BACARDI NEEDS HELP) |
| Nina Oviedo |
| 2/1/2002 |
| 2/1/2002 |
| Date Completed |
| Active |
| 2/1 faxed to Nina. Kathleen would like to know if you can can the 2 answers for Bacardi. If not, she will write a memo. Bj |

FOIA 0014

Melissa Freedman

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Thursday, February 07, 2002 7:15 AM
To: oviadon@sso.org
freedmm@sso.org
Subject: URGENT- CORRECTION OF NAME
Importance: High

Dear Nina,

Thank you for your time and your interest in our case.

Thank you also to Melissa.

I hope I was able to make our case clear enough, but if not let me know.

UNFORTUNATELY, yesterday I gave you the wrong name about the lady from Patent and Trademark Office with whom we have been trying to work with, but without good results.
Her correct name is:

LYNNE BERESFORD

and she was, at least two months ago, Deputy Commissioner for Trademark Examination Policy.

Sorry, for my big mistake.

Jorge

FOIA 0015

May 22, 2002

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Under Secretary Rogan:

I am writing on behalf of Florida-based Bacardi-Martini, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini, Inc. generates close to one billion dollars worth of business a year nationally. The company's domestic headquarters are located in Coral Gables and has a workforce of more than 300 Floridians and over 600 employees throughout the US.

As I understand, since 1997 Bacardi-Martini, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration to the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family that owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by CubaExport and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini, Inc. purchased the Havana Club brand and assets in 1997 from the original owners.

Though Bacardi-Martini, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.

A swift resolution to this matter is imperative. Should you have further questions, please do not hesitate to contact my office. You may also feel free to contact my Washington DC Office at 202/624-5885. Thank you for your consideration of this matter.

Sincerely,

Jeb Bush
Governor

FOIA 0016

Dear :

I am writing on behalf of Florida-based Bacardi-Martini, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

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May 13, 2002

The Honorable James Rogan
Director, US Patent and Trademark Office
Address
City, ST Zip Code

Dear Director Rogan:

I am writing on behalf of Bacardi-Martini, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending request for repeal of a registered name.

Bacardi-Martini, Inc. is a liqueur company based in Florida, which employs ??? employees and reaches annual sales of \$?????. Lack of action on this issue is hurting Bacardi's business opportunities, both domestic and abroad.

Melissa Freedman

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Tuesday, May 14, 2002 5:59 PM
To: freedmm@sso.org
Subject: RE: ANY NEWS

Importance: High

Follow Up Flag: Follow up
Due By: Wednesday, May 15, 2002 9:30 AM
Flag Status: Flagged

Dear Melissa,

Havana Club Holdings is jointly owned by the Cuban government and Pernod-Ricard of France right now and always. We do not believe that CubaExport exists any more and we do not think that CubaExport was ever directly a part of Havana Club Holdings other than through the fact that CubaExport is or was also owned by the Cuban government itself.

Pernod-Ricard can not be the sole owner of Havana Club Holdings because HCH reflects ONLY a partnership to commercialize worldwide the Havana Club brand and the Cuban government IS the ONLY and sole owner of the distilleries, their production, and THE BRAND HAVANA CLUB itself. Pernod-Ricard, only through HCH, owns ONLY the rights to commercialize Havana Club, and has no other asset. Therefore, Pernod-Ricard without the Cuban government CAN NOT DO ANYTHING.

Pernod-Ricard approached the Havana Club original owners (those who were victims of Castro's confiscation) in 1993, after we terminated Pernod as our Bacardi rum distributor in France. They wanted to buy the Arechabalas (family name of original owners) rights, but failed. Then approached Castro and made a deal forming Havana Club Holdings. Bacardi and Arechabalas both wrote letters to Pernod warning them NOT to make a deal with Castro over stolen properties. Pernod reply ignoring the warnings.

After Pernod signed the deal with Castro, the Arechabalas came to Bacardi knowing that for many years we have tried to buy their rights without success.

They were looking for a way to be able to fight back now that this new and additional thief (Pernod) came to aggravate their own situation. We offer to buy and we closed our agreement verbally with them in 1995 and together agreed to start the fight by selling Havana Club made by us in the USA. The final documents were signed in 1997 after a lot of due diligence which the Arechabalas had to complete before they were able to give us clear ownership.

Melissa, the whole process at TTAB (part of PTO) is "stay" right now pending the resolution of a federal litigation which we had to file against PTO this past March 15th complaining about PTO's incredible actions of January 15th of this year when they placed the registration on CubaExport's name. That means that PTO may answer you in the same way. HOWEVER, once Larson denies the OFAC license, we can then withdraw our legal suit against PTO and the whole process at TTAB (PTO) can move faster. We can not take a chance withdrawing the law suit when OFAC is still alive as a serious threat to our case.

All of that means, that the Governor's actions aimed at Larson or above, regarding the OFAC issue, could be much more effective today than those at PTO, for now
Thanks for all your help. Call me or e-mail back with ANY questions.

Jorge

judiciary-
"expired" or "delinquent"
proper terminology
US for Econ, Bus & Ag. Affairs
Alan
Larson # -
647-7575

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Tuesday, February 05, 2002 6:30 AM
To: Oviedo, Nina
Cc: Freedman, Melissa; Gloria Sentenat
Subject: RE: questions to Gov Bush

Thank you.

See you then.

Jorge

marquez@bacardi.com> "Nina Oviedo"
<oviedon@ssso.org> To: "J Rodriguez-Marquez" <jrodriguez-
"Gloria Sentenat" cc: "Melissa Freedman" <freedmm@ssso.org>,
<gsentenat@bacardi.com>
02/04/2002 Subject: RE: questions to Gov Bush
06:01 PM

Gloria, we're located at 444 North Capitol, Suite 349; at North Capitol and E Street NW. We're 1.5 blocks from Union Station (towards the Capitol) and the same building where La Coline is located (big Hill restaurant).

Pls let Jorge know that we'll see him at 1 pm, Wed. Thanks, Nina.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Monday, February 04, 2002 5:54 PM
To: Nina Oviedo
Cc: Gloria Sentenat
Subject: RE: questions to Gov Bush
Importance: High

Nina,
I could be there at 1:00PM and I will wait for you until you come in.

I can do the 3:00PM, but if it is OK by you I prefer the 1:00PM.

I need your address, so please give it to Gloria so she can arrange my arrival on time.

See you Wednesday at 1:00PM (or 1:15PM).

Jorge

FOIA 0020

"Nina Oviedo"
 <oviedon@ssso.org>
 <jrodriguez-marquez@bacardi.com>, "Oviedo,
 Nina" <oviedon@SSONet.sso.org>
 cc: "Lauren Burke"
 <burke@SSONet.sso.org>, "Gloria Sentenat"
 02/04/2002 <gsentenat@bacardi.com>, "Melissa
 Freedman" <freedmm@ssso.org>
 01:11 PM Subject: RE: questions to Gov
 Bush

Jorge----I have an 11:00 a.m. that will take me until 1pm; we could meet at
 1 (might be 1:15) or after 3 pm. I'd like Melissa Freedman to sit in on
 our
 meeting. She handles our business/Treasury/Commerce issues in this office.
 Melissa has a 2pm that will keep her busy until 3.

Gloria----we are swamped right now with our Budget Analysis. Would you
 mind
 calling Jorge to schedule meeting? Thanks, Nina. (202/624-5885)

Lauren----pls put on calendar as soon as Gloria gets back to us. Nina

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
 Sent: Monday, February 04, 2002 9:07 AM
 To: Oviedo, Nina
 Cc: Gloria Sentenat
 Subject: RE: questions to Gov Bush
 Importance: High

Nina,

I have a meeting starting at 8:30AM on Wednesday at the US Chamber of
 Commerce which will end at 11:30AM or a little earlier, I will be free
 after that at any time. Call me at 305-613-5099 which is my cell. You can
 also contact my office in Miami 305-446-9050, my assistant is Gloria
 Sentenat.

Jorge

"Oviedo, Nina"
 <oviedon@SSONet.sso.org>
 <jrodriguez-marquez@bacardi.com>
 t.sso.org>
 To: "J Rodriguez-Marquez"
 cc:
 Subject: RE: questions to Gov
 Bush
 02/04/2002
 06:46 AM

Jorge, glad you got my note.

We have the President's budget out on Monday ---- our Monday and Tuesday will be a zoo in the office. We have a tremendous amount of analysis to complete for the Governor. Wed will be a better day. I'll look at the calendar as soon as I get in this morning. thanks. Nina.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Sat 2/2/2002 9:55 AM
To: Oviedo, Nina
Cc:
Subject: RE: questions to Gov Bush

Good morning Nina, it is Saturday, Feb.2nd and I just got this message from you. I traveled almost all day yesterday. I just called your number and left you a voice message. I will be arriving in Washington DC, Tuesday Feb 5th at 6:30PM and will have a meeting all morning Wednesday 6th. I can see you any time that is convenient for you after I arrive in DC Tuesday or, Wednesday any time for lunch or later. In any event I will call you Monday Feb. 4th in the morning and you can also reach me in my cell (305) 613-5099.

Jorge

| | | |
|----------------------------------|----------|------------------|
| "Nina Oviedo" | To: | "Jorge" |
| <oviedon@ssso.org> | | |
| Rodriguez-Marquez \{Bacardi\}" | | |
| <jrodriguez-marquez@bacardi.com> | cc: | |
| | Subject: | RE: questions to |
| Gov Bush | | |
| 02/01/2002 | | |
| 11:11 AM | | |

Let's try again? I had your address incorrect. Nina

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Friday, February 01, 2002 9:53 AM
To: Jorge Rodriguez-Marquez (Bacardi)
Subject: questions to Gov Bush

Hello Jorge,

FOIA 0022

The Governor forwarded your note to me. I'm the Governor's Director
of the Washington, D.C. office. Could you call me? I can be reached at
202/624-5885. Thanks, Nina.

Nina Oviedo

Director

Office of Governor Jeb Bush

Washington, D.C.

Muniz, Carlos

To: Nina Oviedo
Subject: RE: HELP for a friend

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Monday, February 04, 2002 10:01 PM
To: Nina Oviedo
Cc: Frank R. Jimenez; Kathleen Shanahan; Betty Jordan
Subject: RE: HELP for a friend

call me on the Citrus issue.

Jeb Bush

Please note: Florida has a very broad public records law.
Most written communications to or from state officials
regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Monday, February 04, 2002 1:32 PM
To: Jeb Bush
Cc: Frank R. Jimenez; Kathleen Shanahan; Betty Jordan
Subject: RE: HELP for a friend

Governor,

Just fyi---we've been in touch with Arnold and his friend Andres. We're
working with the State Dept.

On two other cases you referred to us:

Bacardi---we're meeting with them on Wed.

Florida Citrus---We met with Andrew LaVigne last Tuesday on their TPA
issue.

We'll follow-up as necessary. Nina.

Slater Bayliss

From: Kathleen Shanahan
Sent: Monday, January 28, 2002 9:27 PM
To: Jeb Bush
Subject: RE: BACARDI NEEDS HELP

sent note to treasury and ustr today
will follow up mid week

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Sunday, January 27, 2002 6:58 PM
To: Kathleen Shanahan; Arlene Dibenigno
Subject: FW: BACARDI NEEDS HELP
Importance: High

any news on this?

Jeb Bush

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regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Tuesday, January 08, 2002 9:16 PM
To: Jeb Bush
Subject: BACARDI NEEDS HELP
Importance: High

Dear Jeb,
As you know Castro in partnership with Pernod, a French company, has
been
fighting Bacardi since 1996 over the Havana Club brand rights inside the
US.
Bacardi prevailed in Federal Court regarding the dispute.
We also prevailed in Federal Appellate Court, and then the US Supreme
Court
refused to review the case.

The aggressors, unsatisfied with the end results, created an
international
dispute between the European Union and the US over a US law (Section
211)
which they blamed for their repeated defeats in US courts. The EU filed a
complaint at WTO against the US law.
Last week the WTO ruled in favor of the US and Bacardi. This law
prohibits
recognizing rights in the US to any illegally confiscated trademarks in
Cuba.

This should be the end of the line for Castro and Pernod on this issue.
However, since 1997 there are two very relevant and significant issues
which are still unresolved and are damaging to Bacardi.

The US Treasury Department's Office of Foreign Asset Control (OFAC) has been holding a pending license application from Havana Club Holdings (Castro-Pernod) which could grant them some rights to the HC brand. If that license is granted it will be contradicting current US law, plus it will be denying the Federal Court rulings. We have worked with OFAC and with Under Secretary of State Alan Larson for over three years to have this pending license application denied but to no avail..

ISSUE #2

The US Department of Commerce's Patent and Trademark Office (PTO) has in hand since 1997 a Federal Court Mandate instructing them to erase from their records the Havana Club Holdings (Castro and Pernod) registration to the Havana Club brand. Because of the multiple appeals PTO withheld action. But since the US Supreme Court decision in October of 2000 (15 months ago), they have found every excuse not to act on that court mandate. We have been working with PTO and also with Alan Larson on this issue too, but so far, nothing.

We need your help. Perhaps we should meet with Secretary O'Neil and Secretary Evans, or whomever you think might be helpful. I have mentioned this case to Kelley McCullough from Karl Rove's office last December 8th when they visited Miami and have sent her briefings. Al Cardenas also knows of our needs and has talk to some people.

I hope you can help us. We are asking that current laws be respected (issue #1) and that a Federal Court order is complied with (issue#2). Thanks for your time, I am sure you don't have much available. Best regards,

Jorge

Muniz, Carlos

From: Kathleen Shanahan [kathleen@jeb.org]
Sent: Sunday, February 17, 2002 10:51 PM
To: Oviedo, Nina
Subject: FW: BACARDI NEEDS HELP

Importance: High

i sent this to you all to ck out w/treasury a week or so back
any update?

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Sunday, February 17, 2002 8:05 PM
To: Kathleen Shanahan
Subject: FW: BACARDI NEEDS HELP
Importance: High

any news?

Jeb Bush

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regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Tuesday, January 08, 2002 9:16 PM
To: Jeb Bush
Subject: BACARDI NEEDS HELP
Importance: High

Dear Jeb,
As you know Castro in partnership with Pernod, a French company, has
been
fighting Bacardi since 1996 over the Havana Club brand rights inside the
US.
Bacardi prevailed in Federal Court regarding the dispute.
We also prevailed in Federal Appellate Court, and then the US Supreme
Court
refused to review the case.

The aggressors, unsatisfied with the end results, created an
international
dispute between the European Union and the US over a US law (Section
211)
which they blamed for their repeated defeats in US courts. The EU filed a
complaint at WTO against the US law.
Last week the WTO ruled in favor of the US and Bacardi. This law
prohibits
recognizing rights in the US to any illegally confiscated trademarks in
Cuba.

This should be the end of the line for Castro and Pernod on this issue.
However, since 1997 there are two very relevant and significant issues

FOIA 0027

which are still unresolved and are damaging to Bacardi.

ISSUE #1

The US Treasury Department's Office of Foreign Asset Control (OFAC) has been holding a pending license application from Havana Club Holdings (Castro-Pernod) which could grant them some rights to the HC brand. If that license is granted it will be contradicting current US law, plus it will be denying the Federal Court rulings. We have worked with OFAC and with Under Secretary of State Alan Larson for over three years to have this pending license application denied but to no avail.

ISSUE #2

The US Department of Commerce's Patent and Trademark Office (PTO) has in hand since 1997 a Federal Court Mandate instructing them to erase from their records the Havana Club Holdings (Castro and Pernod) registration to the Havana Club brand. Because of the multiple appeals PTO withheld action. But since the US Supreme Court decision in October of 2000 (15 months ago), they have found every excuse not to act on that court mandate. We have been working with PTO and also with Alan Larson on this issue too, but so far, nothing.

We need your help.

Perhaps we should meet with Secretary O'Neil and Secretary Evans, or whomever you think might be helpful. I have mentioned this case to Kelley McCullough from Karl Rove's office last December 8th when they visited Miami and have sent her briefings. Al Cardenas also knows of our needs and has talk to some people.

I hope you can help us. We are asking that current laws be respected (issue #1) and that a Federal Court order is complied with (issue#2). Thanks for your time, I am sure you don't have much available. Best regards,

Jorge

Slater Bayliss

From: Jeb Bush
Sent: Wednesday, January 09, 2002 10:37 AM
To: 'J Rodriguez-Marquez'
Subject: RE: BACARDI NEEDS HELP

Jorge, I will see what I can do.

Jeb Bush

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-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Tuesday, January 08, 2002 9:16 PM
To: Jeb Bush
Subject: BACARDI NEEDS HELP
Importance: High

Dear Jeb,

As you know Castro in partnership with Pernod, a French company, has been fighting Bacardi since 1996 over the Havana Club brand rights inside the US.

Bacardi prevailed in Federal Court regarding the dispute. We also prevailed in Federal Appellate Court, and then the US Supreme Court refused to review the case.

The aggressors, unsatisfied with the end results, created an international dispute between the European Union and the US over a US law (Section 211) which they blamed for their repeated defeats in US courts. The EU filed a complaint at WTO against the US law. Last week the WTO ruled in favor of the US and Bacardi. This law prohibits recognizing rights in the US to any illegally confiscated trademarks in Cuba.

This should be the end of the line for Castro and Pernod on this issue. However, since 1997 there are two very relevant and significant issues which are still unresolved and are damaging to Bacardi.

ISSUE #1

The US Treasury Department's Office of Foreign Asset Control (OFAC) has been holding a pending license application from Havana Club Holdings (Castro-Pernod) which could grant them some rights to the HC brand. If that license is granted it will be contradicting current US law, plus it will be denying the Federal Court rulings. We have worked with OFAC and with Under Secretary of State Alan Larson for over three years to have this pending license application denied but to no avail.

ISSUE #2

The US Department of Commerce's Patent and Trademark Office (PTO) has in hand since 1997 a Federal Court Mandate instructing them to erase from their records the Havana Club Holdings (Castro and Pernod) registration to the Havana Club brand. Because of the multiple appeals PTO withheld action. But since the US Supreme Court decision in October of 2000 (15 months ago), they have found every excuse not to act on that court mandate.

FOIA 0029

We have been working with PTO and also with Alan Larson on this issue too, but so far, nothing.

We need your help.

Perhaps we should meet with Secretary O'Neil and Secretary Evans, or whomever you think might be helpful.

I have mentioned this case to Kelley McCullough from Karl Rove's office last December 8th when they visited Miami and have sent her briefings. Al Cardenas also knows of our needs and has talk to some people.

I hope you can help us. We are asking that current laws be respected (issue #1) and that a Federal Court order is complied with (issue#2). Thanks for your time, I am sure you don't have much available. Best regards,

Jorge

Slater Bayliss

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Thursday, January 10, 2002 9:40 AM
To: Jeb Bush
Subject: Thank you---BACARDI NEEDS HELP

Thank you for your help.
Jorge

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Thursday, February 07, 2002 7:15 AM
To: Oviedo, Nina
Cc: Freedman, Melissa
Subject: URGENT- CORRECTION OF NAME

Importance: High

Dear Nina,

Thank you for your time and your interest in our case.
Thank you also to Melissa.
I hope I was able to make our case clear enough, but if not let me know.

UNFORTUNATELY, yesterday I gave you the wrong name about the lady from
Patent and Trademark Office with whom we have been trying to work with, but
without good results..
Her correct name is:

LYNNE BERESFORD

and she was, at least two months ago, Deputy Commissioner for Trademark
Examination Policy.

Sorry, for my big mistake.

Jorge

FOIA 0032

Muniz, Carlos

From: Shanahan, Kathleen [Kathleen.Shanahan@MyFlorida.com]
Sent: Monday, February 18, 2002 3:22 PM
To: Oviedo, Nina
Subject: how are you feeling? bacardi status?

FOIA 0033

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Wednesday, February 20, 2002 6:34 PM
To: Oviedo, Nina
Cc: Freedman, Melissa; 'J Rodriguez-Marquez'
Subject: RE: Updating on PTO Issue

Importance: High

Nina,

Thank you for this very important message.

Please, fax the notice to our New York lawyers to my private fax
305-446-6859 here in my office.

Thank you and the Governor for your help.
The meeting at PTO and also at Treasury will be helpful.

I will see you and the Governor on Monday at The Florida House.

Jorge

marquez@bacardi.com>
<freedman@ssso.org>
"Nina Oviedo"
<oviedon@ssso.org>
To: "'J Rodriguez-Marquez'" <jrodriguez-
cc: "Melissa Freedman \ (E-mail) "

Subject: RE: Updating on PTO Issue

02/20/2002
05:37 PM

Jorge,

Today, Melissa and I spoke with a lawyer in the PTO who has followed your case (Eleanor Metzner). She confirmed that on 01/15, PTO notified your lawyers (New York) about the transfer of the registration. She further explained that the Appeals Court followed the district court's ruling and that the Judgment reinstated the "status quo of October 29, 1993". The Judge's order did not "cancel" the registration.

The attorney faxed copies of the Judgment and although I'm not a patent & trademark lawyer... Bacardi did receive a Partial Judgment rolling back the registration to 10/93, to Cubaexport. It would appear that you (Bacardi) are now free to bring action against Cubaexport if you so desire. (I also have copies of the notice to the NY lawyers, if you send me a fax number, I'll fax it to you.)

I have asked the PTO office whether they might meet with us/you and provide some guidance. As you know the PTO office has very serious rules and she will be checking with her supervisors to see if it is permissible.

We also have calls in to Treasury.

I have updated the Governor and he asked me to contact you. I also mentioned to the Governor that you will attend lunch on Monday. We can talk more then and hopefully I will have heard from Treasury.

Nina.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Wednesday, February 20, 2002 11:49 AM
To: oviedon@ssso.org
Subject: Updating on PTO Issue
Importance: High

I met with Alan Larson at State Department last Thursday afternoon and he told me that his office had been informed by PTO that they had acted on canceling the Havana Club Holdings registration, BUT that they had it now under the name of Cuba Export.
Cuba Export is the Castro's government entity that made the illegal transfer to Havana Club Holdings in 1995, which caused them to lose the Federal Court case in 1997. VERY STRANGE MOVE.

We have not been notified AT ALL by PTO of any change of any kind; furthermore, our lawyers have been calling Lynne Beserford at PTO since Friday morning and she has not returned any of our calls.

I do not understand WHAT is happening at PTO, but nothing has been logical in their behavior with us for several years.

Any news from your end.

Jorge

Muniz, Carlos

From: Yablonski, Brian [Brian.Yablonski@MyFlorida.com]
Sent: Wednesday, February 20, 2002 1:49 PM
To: Shanahan, Kathleen; Oviedo, Nina
Subject: RE: IMPORTANT/URGENT: REQUEST FROM SEC EVANS

would they be announcing anything news worthy? anything specific to florida?

-----Original Message-----

From: Shanahan, Kathleen
Sent: Wednesday, February 20, 2002 12:25 PM
To: Yablonski, Brian; Struhs, David
Subject: FW: IMPORTANT/URGENT: REQUEST FROM SEC EVANS
Importance: High

fyl

could be good

-----Original Message-----

From: Adam Moniz [mailto:moniza@sao.org]
Sent: Wednesday, February 20, 2002 10:44 AM
To: betty.jordan@myflorida.com; betty.hampton@myflorida.com; Governor Bush; kathleen.shanahan@myflorida.com; katie.bau@myflorida.com
Subject: IMPORTANT/URGENT: REQUEST FROM SEC EVANS
Importance: High

BETTY AND BETTY-----PLS PRINT FOR GOV AND KS.

Secretary Evan's intergovernmental office called this morning and asked if you might be interested in doing a "Florida Press briefing" with Sec Evans on the economy.
VERY NICE OFFER!

You are already scheduled to meet with the FL-DC Press at noon, on Monday, at the Florida House. If you're interested, we could see if the Sec's schedule is available. Our FL press would certainly love it----right Katie?

also, the Bacardi issue is partly a Commerce Dept issue---Patents and Trademarks---and Jorge Rodriguez will be sitting upstairs for the Florida House Luncheon immediately after the press roundtable. He would be WOWed.

The only down-side I see---if it is a down-side---you'll likely get questions on Destin Dome, maybe some Enron questions too.

Pls advise. I need to get back to Commerce quickly. thanks, nina

FOIA 0036

Muniz, Carlos

From: Jeb Bush [jeb@jeb.org]
Sent: Wednesday, February 20, 2002 11:06 PM
To: Oviedo, Nina; Shanahan, Kathleen
Cc: Freedman, Melissa; Jimenez, Frank
Subject: RE: Barcardi Update
good work, Nina. thank you.

Jeb Bush

.....
Please note: Florida has a very broad public records law. Most written communications to or from state officials regarding state business are public records available to the public and media upon request. Your e-mail communications may therefore be subject to public disclosure.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Wednesday, February 20, 2002 11:09 PM
To: Jeb Bush; 'KaS (E-mail)'
Cc: 'Melissa Freedman (E-mail)'; 'Frank R. Jimenez (E-mail)'
Subject: RE: Barcardi Update

Jorge and I traded a couple of e-mails tonight. He had not received notice of the actions by the Patent/Trade office. I faxed the order to him. Also told him we would try to arrange meetings with him at Commerce and Treasury. He was very appreciative of your efforts and looks forward to seeing you on Monday. Nina

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Wednesday, February 20, 2002 10:52 PM
To: Nina Oviedo; KaS (E-mail)
Cc: Melissa Freedman (E-mail); Frank R. Jimenez (E-mail)
Subject: RE: Barcardi Update

please contact Jorge and let me know. thank you.

Jeb Bush

.....
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-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Wednesday, February 20, 2002 4:54 PM
To: Jeb Bush; KaS (E-mail)
Cc: Melissa Freedman (E-mail); Frank R. Jimenez (E-mail)
Subject: Barcardi Update

FOIA 0037

Governor,

Melissa and I spoke with, Eleanor, the trademark attorney who has been following the Bacardi issue at the US Patent & Trademark Office (US Dept of Commerce).

Eleanor confirmed that on January 15, 2002, the Office of Patents & Trademarks notified Bacardi that they complied with the Judge's order and "changed the registration" as the Judge's ordered decreed. She has faxed us a copy of the notice sent to Bacardi's lawyers.

She further explained that the Appeals Court followed the district court's ruling and that the Judgment reinstated "status quo" of October 29, 1993. The Order did not "cancel" the registration, as Jorge believes (and as he explained to Melissa and me 10 days ago).

The attorney faxed copies of the Judgment and although I'm not a trademarks lawyer... Bacardi received a Partial Judgment rolling back the registration to 10/93, to Cubaexport (the Cuban/Castro company). Bacardi is now free to bring action against Cubaexport if it so desires.

Obviously this is a very long and complicated mess---I asked Eleanor whether she could meet with Bacardi and provide some guidance. She has to check with higher-ups to see if it's permissible---Patents & Trademarks office employees have very serious rules. We also have calls in to Treasury for their role.

More later I'm sure. I'll be in touch with Jorge (on your behalf).

Reminder---he'll be at the Florida House Luncheon. Last year Bacardi contributed over \$15K to the Florida House...great supporters of our Florida embassy.

Nina.

Muniz, Carlos

From: Shanahan, Kathleen [Kathleen.Shanahan@MyFlorida.com]
Sent: Thursday, February 21, 2002 9:55 AM
To: Oviedo, Nina
Subject: RE: Bacardi Update

nice work nina
thank you!

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Wednesday, February 20, 2002 11:09 PM
To: 'Jeb Bush'; 'KaS (E-mail)'
Cc: 'Melissa Freedman (E-mail)'; 'Frank R. Jimenez (E-mail)'
Subject: RE: Bacardi Update

Jorge and I traded a couple of e-mails tonight. He had not received notice of the actions by the Patent/Trade office. I faxed the order to him. Also told him we would try to arrange meetings with him at Commerce and Treasury. He was very appreciative of your efforts and looks forward to seeing you on Monday. Nina

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Wednesday, February 20, 2002 10:52 PM
To: Nina Oviedo; KaS (E-mail)
Cc: Melissa Freedman (E-mail); Frank R. Jimenez (E-mail)
Subject: RE: Bacardi Update

please contact Jorge and let me know. thank you.

Jeb Bush

Please note: Florida has a very broad public records law. Most written communications to or from state officials regarding state business are public records available to the public and media upon request. Your e-mail communications may therefore be subject to public disclosure.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Wednesday, February 20, 2002 4:54 PM
To: Jeb Bush; KaS (E-mail)
Cc: Melissa Freedman (E-mail); Frank R. Jimenez (E-mail)
Subject: Bacardi Update
Governor,

Melissa and I spoke with, Eleanor, the trademark attorney who has been following the Bacardi issue at the US Patent & Trademark Office (US Dept of Commerce).

Eleanor confirmed that on January 15, 2002, the Office of Patents & Trademarks notified Bacardi that they complied with the Judge's order and "changed the registration" as the judge's ordered decreed. She has faxed us a copy of the notice sent to Bacardi's lawyers.

She further explained that the Appeals Court followed the district court's ruling and that the Judgment reinstated "status quo" of October 29, 1993. The Order did not "cancel" the registration, as Jorge believes (and as he explained to Melissa and me 10 days ago).

The attorney faxed copies of the Judgment and although I'm not a trademarks lawyer... Bacardi received a Partial Judgment rolling back the registration

to 10/93, to Cubaexport (the Cuban/Castro company). Bacardi is now free to bring action against Cubaexport if it so desires.

Obviously this is a very long and complicated mess----I asked Eleanor whether she could meet with Bacardi and provide some guidance. She has to check with higher-ups to see if it's permissible---Patents & Trademarks office employees have very serious rules. We also have calls in to Treasury for their role.

More later I'm sure. I'll be in touch with Jorge (on your behalf).

Reminder---he'll be at the Florida House Luncheon. Last year Bacardi contributed over \$15K to the Florida House...great supporters of our Florida embassy.

Nina.

Muniz, Carlos

From: Canady, Charles T. [Charles.Canady@MyFlorida.com]
Sent: Tuesday, February 26, 2002 12:37 PM
To: Oviedo, Nina
Subject: RE: Havana Club

He called me simply because he knows me, and knows that I am the Gov's General Counsel. Jon was the Scaff Director and Deputy General Counsel for the House Judiciary Committee. No further action is necessary in response to his call to me.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Tuesday, February 26, 2002 11:38 AM
To: 'Canady, Charles T.'; 'Freedman, Melissa'
Subject: RE: Havana Club

Why would he call you? Do we need to touch base with him? The Gov asked us to help with Bacardi and their Patent & Trademark issue. Nina

-----Original Message-----

From: Canady, Charles T. [mailto:Charles.Canady@MyFlorida.com]
Sent: Monday, February 25, 2002 9:27 AM
To: Oviedo, Nina; Freedman, Melissa
Subject: FW:Havana Club

I was contacted by Jon Dudas, who is a special assistant to Jim Rogan, about this. I told him I was not familiar with the issues. FYI--I just wanted you to know that Dudas had spoken to me.

-----Original Message-----

From: Jon.Dudas@USPTO.GOV [mailto:Jon.Dudas@USPTO.GOV]
Sent: Monday, February 25, 2002 9:16 AM
To: charles.canady@myflorida.com
Subject:

Charles,

It was great to hear you are doing well. Our office of Legislative and International Affairs was contacted by Melissa Friedman and Nina Oviedo. It was an informational inquiry regarding the status of U.S. Trademark Registration No. 1,031,651 ("HAVANA CLUB AND DESIGN"). This mark is the subject of litigation in the Southern District of New York. Jon

FOIA 0041

Muniz, Carlos

From: Jeb Bush [jeb@jeb.org]
Sent: Tuesday, February 26, 2002 8:10 PM
To: Oviedo, Nina; Kathleen Shanahan
Subject: FW: THANK YOU

Importance: High

Jeb Bush

Please note: Florida has a very broad public records law.
Most written communications to or from state officials
regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Tuesday, February 26, 2002 5:56 PM
To: Jeb Bush
Subject: THANK YOU
Importance: High

Dear Jeb,

Thank you for your valuable support regarding our problems at Commerce
and
Treasury.

Both Nina Oviedo and Melissa Freedman are GREAT people and they are both
helping very effectively.

The meeting yesterday at 4:00 PM at Patent & Trademark Office (PTO)
reconfirmed to us that, at least one, and most likely two female career
lawyers at PTO have personal problems with our Havana Club case. One of
these two lawyers was present at the meeting yesterday and in some of
her
answers to my complaints she incriminated herself by revealing personal
negative feelings about our case.

With your continued support I am sure we can have it solved soon. I will
continue working with Nina and Melissa.

Thank you for the wonderful cufflinks I received through Slater.

GRACIAS MIL,

Jorge

FOIA 0042

Slater Bayliss

From: Jeb Bush
Sent: Tuesday, February 26, 2002 8:10 PM
To: 'J Rodriguez-Marquez'
Subject: RE: THANK YOU

thank you Jorge. I hope it all works out.

Jeb Bush

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regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Tuesday, February 26, 2002 5:56 PM
To: Jeb Bush
Subject: THANK YOU
Importance: High

Dear Jeb,

Thank you for your valuable support regarding our problems at Commerce and Treasury.

Both Nina Oviedo and Melissa Freedman are GREAT people and they are both helping very effectively.

The meeting yesterday at 4:00 PM at Patent & Trademark Office (PTO) reconfirmed to us that, at least one, and most likely two female career lawyers at PTO have personal problems with our Havana Club case. One of these two lawyers was present at the meeting yesterday and in some of her answers to my complaints she incriminated herself by revealing personal negative feelings about our case.

With your continued support I am sure we can have it solved soon. I will continue working with Nina and Melissa.

Thank you for the wonderful cufflinks I received through Slater.

GRACIAS MIL,

Jorge

FOIA 0043

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]
Sent: Monday, March 18, 2002 5:41 PM
To: Oviedo, Nina
Subject: RE: Bacardi and Patent & Trademark Office

I don't have Jon's email, but may be able to get it from his office.

I will do it by email...and CC you?

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Monday, March 18, 2002 5:45 PM
To: 'Melissa Freedman'
Subject: RE: Bacardi and Patent & Trademark Office

I wouldn't "formalize" it....do you have Jon's e-mail address.

-----Original Message-----

From: Melissa Freedman [mailto:freedmm@sso.org]
Sent: Monday, March 18, 2002 5:28 PM
To: Nina Oviedo
Subject: RE: Bacardi and Patent & Trademark Office

Jon Dudas, from PTO, called me about two weeks ago to make sure that the meeting we had with Eleanor Meltzer and himself, has been helpful. We talked a little about the case. Now that I know Bacardi has sent in the request for cancellation of CubaExport's registration, I thought I would send Jon a note on our stationary, thanking him for his time on the case, and letting him know that Bacardi has made their move. Please let me know if I should go ahead with that.

(Jorge did not like some of the issues that Eleanor Meltzer brought up in our meeting, so keeping up contact with Jon would be the most preferred method to Bacardi, I am sure.)

Otherwise, we should do nothing for the moment. We need to wait a few weeks until PTO takes action, which from all indications will be favorable. Then its on to Commerce...

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Monday, March 18, 2002 5:25 PM
To: Melissa Freedman (E-mail)
Subject: FW: Bacardi and Patent & Trademark Office
Importance: High

What do I need to do here?

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Monday, March 18, 2002 4:57 PM
To: oviedon@sso.org; freedmm@sso.org
Subject: Bacardi and Patent & Trademark Office
Importance: High

Dear Nina and Melissa,

This past Friday, March 15th our lawyers Kelley Drye & Warren of New York, filed with Patent And Trademark Office a motion for cancellation of the CubaExport registration on Summary Judgment.

FOIA 0044

Below you can find two attachments:

one is the complete set of documents as filed Friday with PTO;

the other shows most (but not all) of the key points extracted from the documents filed with PTO, which I selected only for your easy reading.

(See attached file: PTO-Summary Judgment-3-15-02.DOC) (See
attached file: PTO- Key Captions from Summary Judgment-3-15-02.doc)

Since our meeting at PTO, Monday February 25th our lawyers have also filed an official complaint with PTO showing them that they DID NOT notify Bacardi of their decision dated January 15th, even though they have insisted they did. Last week PTO finally issued a formal reply to us admitting that in fact the notification to Bacardi was never sent out. It is the second time in 18 months that PTO finds a problem notifying Bacardi on issues of Havana Club.

Assuming that now PTO would "want to" act equitably and follow the straight line, (I will not hold my breath on that), this new request from us now asking to cancel Cuba Export from their records should put the final end to this ever lasting problem.

Cuba Export, as you might remember is Castro's government entity which registered Havana Club in the US in 1976 and later sold all its rights to Havana Club Holdings (HCH) which is the partnership between Castro and Pernod-Ricard, the French beverage company. HCH lost its rights in Federal Court and Cuba Export willingly lost theirs when they sold them to HCH.

Would you please, help us by making sure that Patent and Trademark Office's Mr. Dudas knows that all they need to do now is be very much aware of this motion for summary judgment, so that it can go through its normal process without any undue negative "influence" from certain parties known to us.

Let me know if you have any questions.

Jorge

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Monday, March 18, 2002 4:57 PM
To: Oviedo, Nina; Freedman, Melissa
Subject: Bacardi and Patent & Trademark Office

Importance: High



PTO-Summary PTO- Key Captions
Judgment-3-15-02.D. from Summary...

Dear Nina and Melissa,

This past Friday, March 15th our lawyers Kelley Drye & Warren of New York, filed with Patent And Trademark Office a motion for cancellation of the CubaExport registration on Summary Judgment.

Below you can find two attachments:

one is the complete set of documents as filed Friday with PTO;

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Would you please, help us by making sure that Patent and Trademark Office's Mr. Dudas knows that all they need to do now is be very much aware of this motion for summary judgment, so that it can go through its normal process without any undue negative "influence" from certain parties know to us.

Let me know if you have any questions.

Jorge

FOIA 0046

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GALLEON S.A.,
BACARDI-MARTINI U.S.A., INC., and
BACARDI & COMPANY LIMITED,

Petitioners,

-against-

HAVANA CLUB HOLDINGS, S.A. and
HAVANA RUM & LIQUORS, S.A. d/b/a H.R.L.,
S.A.,

Respondents.

x

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Cancellation No. 24,108

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x

MEMORANDUM OF LAW IN SUPPORT OF
PETITIONERS' MOTION TO RESUME PROCEEDINGS,
TO SUBSTITUTE PARTIES AND FOR SUMMARY JUDGMENT

FOIA 0047

I.

PRELIMINARY STATEMENT

Petitioners, Bacardi & Company Ltd., formerly Galleon, S.A., and Bacardi U.S.A., Inc., formerly Bacardi-Martini U.S.A., Inc., (collectively hereinafter: "Bacardi"), respectfully submit this memorandum of law in support of their Motion to Resume Proceedings in Cancellation No. 24,108, to Substitute Parties and for Summary Judgment that is being filed with this memorandum.

On October 26, 2001, Nicholas P. Godici, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office (the "USPTO") issued an Order To Show Cause why the Director of the USPTO should not now rectify the USPTO's records to reflect the Order of Judge Shira Scheindlin dated October 20, 1997¹ (the "Cancellation Order": a copy of which is attached as Exhibit A) invalidating the recorded assignments of U.S. Registration No. 1,031,651 of the trademark HAVANA CLUB for "rum" (the "U.S. HAVANA CLUB Registration") and canceling the extant registration.

On January 15, 2002, after having considered the parties' submissions in response to the Order To Show Cause, Anne H. Chasser, Commissioner for Trademarks, issued a Notice (the "Notice") stating that "the records of the USPTO will be rectified to reflect the [Cancellation Order] invalidating the recorded assignments [of the U.S. HAVANA CLUB Registration from Empresa Cubana Exportadora De Alimentos y Productos Varios, S.A. ("Cubaexport") to Havana Rum & Liquors, S.A. ("HRL") and from HRL to Havana Club Holdings, S.A. ("HCH")]."²

¹ *Havana Club Holding, S.A. v. Galleon, S.A.*, No. 96 Civ. 9655, slip op. (S.D.N.Y. filed Oct. 20, 1997) (Partial Judgment).

² The recorded assignments were as follows:

(1) Reel: 1104 Frame: 0046

Assignor: Empresa Cubana Exportadora De Alimentos y

Accordingly, the USPTO's registration records will also be rectified to conform with the assignment records." That Notice, however, inexplicably failed to refer to the most critical aspect of the Cancellation Order – cancellation of the extant U.S. Registration No. 1,031,651 of the mark HAVANA CLUB in the name of HCH.

The District Court unambiguously ordered that:

8. Any rights that Havana Club Holding, S.A. may have had, may have or claims to have had in the Registration of the HAVANA CLUB trademark (U.S. Reg. No. 1,031,651) from forever until today are hereby canceled.

In the United States, a certificate of registration merely confers a presumption of ownership of the registered mark, and the District Court has declared, without room for equivocation, that HCH's presumption of ownership is eviscerated. The U.S. HAVANA CLUB Registration, therefore, must be expunged from the records of the USPTO as no registration can persist on the USPTO records once a final judgment has decreed that the record holder, in fact, owns no interest in the registered mark. The renewal application and declaration of non-use filed by HCH with respect to that registration must be stricken as well. The same logic that requires deletion of the HCH assignments as nullities since HCH never became the owner of the U.S. HAVANA CLUB Registration also calls for deletion of all subsequent filings by HCH with respect to that registration as nullities.

HCH was, in fact, deleted from the records of the USPTO as record holder of Registration No. 1,031,651, although the Notice is silent on that point. Without citing any

Productos Varios, S.A. DBA Cubaexport

Assignee: Havana Rum and Liquors, S.A.

(2) Reel: 1129 Frame: 0428

Assignor: Havana Rum and Liquors, S.A.

Assignee: Havana Club Holdings, S.A. DBA HCH, S.A.

FOIA 0049

authority for this action, however, the name of Cubaexport was substituted by the USPTO for HCH as the record holder of the U.S. HAVANA CLUB Registration. Cubaexport was, at best, left by the Cancellation Order with a claim to whatever rights it had in that registration on or around January 1994 but the Cancellation Order explicitly acknowledged that any rights claimed by Cubaexport may have been "lost as a result of acts or omissions of Cubaexport." (See Cancellation Order at ¶ 10). Cubaexport has elected not to pursue any ownership claim, but, in any event, Registration No. 1,031,651 expired as a result of Cubaexport's omissions in failing to file a renewal application. The USPTO has no power under the Lanham Act to ignore that omission and list U.S. Registration No. 1,031,651 as being presently owned by Cubaexport.

Bacardi also moves the Board to resume proceedings in Cancellation No. 24,108, and to substitute Cubaexport as respondent. As the Cancellation Order establishes, Cubaexport, not HCH, was the sole claimant to the U.S. HAVANA CLUB Registration and thus was the real party in interest when the cancellation proceeding was initiated. Finally, Bacardi further moves for summary judgment because there is no genuine issue of material fact and Registration No. 1,031,651 must be cancelled as a matter of law.

II.

BACKGROUND FACTS

A. Facts Established In Havana Club Litigation

Jose Arechabala, S.A. ("JASA"), a Cuban corporation headquartered in Cardenas, Cuba, succeeded to the Arechabala family rum business founded in the late 1800's.³ In the early 1930's, JASA adopted and used the trademark HAVANA CLUB for rum produced mainly for

³ These facts are taken from the findings of the District Court published at 974 F. Supp. 302 (S.D.N.Y. 1997) and 62 F. Supp.2d 1085 (S.D.N.Y. 1999) and must be taken as established by the USPTO. Similarly, the conclusions of law are *res judicata* and cannot

export to the United States. Sales of JASA's HAVANA CLUB rum began in the United States at least as early as 1934. In that year, Cuban Registration No. 53,614 of the mark HAVANA CLUB was issued to JASA for "alcohol, rum, etc." On May 14, 1935, the trademark HAVANA CLUB for "Ethyl alcohol, rum, etc." was registered by JASA under No. 324,385 in the USPTO. On June 16, 1936, JASA registered the trademark HAVANA CLUB and Design for "rum, etc." in the USPTO under No. 335,919.

During the years from 1934 to 1960, JASA continued to export, distribute, and sell HAVANA CLUB rum in the United States. JASA's HAVANA CLUB rum was produced in both Cuba and Puerto Rico. "Havana Club" was also used by JASA as a trade name to identify that part of its business dealing with the production and sale of HAVANA CLUB rum.

In the Fall of 1960, the Castro regime promulgated Law No. 890 which by its terms expropriated the physical assets, property, accounts and business records of JASA. That same year, JASA assets were seized at gun point by Cuban special forces. No compensation was ever paid directly or indirectly to JASA or its owners by the Cuban government for the physical and intangible assets confiscated, including the HAVANA CLUB mark. These assets were worth at least 25 million dollars (4,000 pesetas) in 1960.

Cuba soon began selling HAVANA CLUB rum made in the confiscated JASA distillery. In the 1960's, all the registrations of the HAVANA CLUB trademark formerly owned by JASA were put in the name of Cubaexport, a state-owned foreign trade enterprise. In 1974, Cubaexport applied to the USPTO to register the trademark HAVANA CLUB under Section 44 of the Lanham Act, based on a Cuban registration of that mark. The U.S. HAVANA CLUB Registration issued to Cubaexport for an initial term of 20 years in 1976.

be reconsidered at this point. See *Federated Dep't Stores, Inc. v. Motie*, 452 U.S. 394, 398 (1981).

The rights to the HAVANA CLUB trademark for rum in the United States and the U.S. HAVANA CLUB Registration were purportedly transferred by Cubaexport first to HRL, another Cuban company, and then to HCH in late 1993. The worldwide rights to the trademark HAVANA CLUB, including ostensibly the rights to distribute HAVANA CLUB rum in the United States, were transferred from Cubaexport to HRL by assignment deed dated October 29, 1993. Also transferred to HRL were all of the assets associated with the HAVANA CLUB rum business. The personnel from Cubaexport handling the rum business were transferred from Cubaexport to HRL. The files of the rum business went as well. Thereafter, HRL transferred all the worldwide rights it had to the trademark HAVANA CLUB to HCH, also ostensibly including the U.S. trademark rights, the U.S. HAVANA CLUB Registration, and any associated goodwill. It is undisputed that Cubaexport ceased all sales of HAVANA CLUB rum outside of Cuba prior to 1994.

The putative transfers of the U.S. rights to the HAVANA CLUB mark and U.S. HAVANA CLUB Registration were then documented through a series of assignments that were dated as of 1994 and were subsequently recorded in the USPTO. Cubaexport executed an agreement, dated January 10, 1994, under which the U.S. rights to the HAVANA CLUB mark and U.S. HAVANA CLUB Registration were assigned to HRL. HRL by deed dated June 22, 1994 assigned its interest in the HAVANA CLUB mark and the related U.S. HAVANA CLUB Registration to HCH. The recorded assignments recited that the goodwill associated with the mark and U.S. HAVANA CLUB Registration was conveyed as well. HCH then filed a renewal application for the U.S. HAVANA CLUB Registration in its own name in January 1996, containing an excusable nonuse declaration asserting that but for the embargo HCH would sell

HAVANA CLUB rum in the United States. (A copy of that renewal application is attached as Exhibit B).

The District Court held that the assignments of the HAVANA CLUB mark and the U.S. HAVANA CLUB Registration by Cubaexport to HRL and then to HCH were *void ab initio* as violations of the Trading With the Enemy Act and the Cuban Asset Control Regulations. As a result, as appears in the Cancellation Order, HCH never acquired any interest whatsoever in the HAVANA CLUB mark from Cubaexport.⁴

B. Facts Ascertainable From USPTO Records

It is undisputed that Cubaexport never filed the required application to renew the U.S. HAVANA CLUB Registration. Cubaexport also did not file an excusable non-use declaration in January 1996.⁵

Cubaexport's original registration was obtained under Section 44 of the Lanham Act, 15 U.S.C.A. § 1126 (West 1997), which requires a foreign registrant like Cubaexport to comply with the Lanham Act's provisions in order to acquire and maintain rights in marks registered here. *See, e.g., Restatement (Third) Unfair Competition* § 18 (1993). Cubaexport's failure to adhere to the provisions of the Lanham Act governing renewal is, therefore, also inexcusable.

⁴ The District Court's Cancellation Order stated: "nothing herein shall prevent the defendants or others from contesting those rights or contending that said rights were lost as a result of acts or omissions by Cubaexport." (See Cancellation Order at ¶ 10). The "omissions" included the fatal failure to file a renewal application and the "acts" constituted abandonment.

⁵ Cubaexport contracted away the right to sell HAVANA CLUB rum in the United States should the embargo be lifted. HCH had that contractual right.

III.

INTRODUCTION TO ARGUMENT

The Cancellation Order is now a final unappealable judgment on the merits and unequivocally provides: (a) that neither HCH nor HCI ever obtained any rights whatsoever in the United States in the HAVANA CLUB mark (See Cancellation Order at ¶ 6), and (b) that any right HCH ever claimed in the U.S. HAVANA CLUB Registration is cancelled (*Id.* at ¶ 8).

For the reasons discussed below, there is no legal basis for Cubaexport to be recognized as the current owner of Registration No. 1,031,651 for the HAVANA CLUB trademark for rum. The invalid assignments were properly deleted from the USPTO records in accordance with the Cancellation Order. Cubaexport, therefore, was the sole claimant to ownership of U.S. Registration No. 1,031,651, during the time period when renewal was due. In this limited sense, whatever rights Cubaexport had before the null transfers were "restored" as of the 1994 date of abortive transfers. But Cubaexport never filed the mandatory renewal application for the U.S. HAVANA CLUB Registration as is required by the Lanham Act. Since HCH never was the registrant and never had a proprietary interest in the U.S. HAVANA CLUB Registration, HCH's renewal was a nullity like the assignments. It should be noted that, HCH and HCI have a clear conflict with Cubaexport due to threatened litigation by HCH and HCI against HRL, a Cuban state enterprise, like Cubaexport. (See Testimony of Noel Adrian, Managing Director of HCI, District Court Trial Tr., Jan. 20, 1999, at pp. 240-41, attached as Exhibit C). That deficiency cannot be cured, for the Director has no authority now to accept a renewal application by Cubaexport long after the statutory time period for filing the renewal application has expired. Consequently, U.S. Registration No. 1,031,651 of the HAVANA CLUB mark listing Cubaexport as record holder must be expunged from the records of the USPTO.

IV.

ARGUMENT

A. Cancellation No. 24,108 Should Be Resumed With Cubaexport Substituted As The Respondent

Cancellation No. 24,108 was suspended pending the outcome of the federal litigation between the parties that resulted in the Partial Judgment in *Havana Club Holding, S.A. v. Galleon S.A.*, 96 Civ. 9655 (SS), which is at issue here. That litigation has long since concluded, appeals have been taken, and a final decision on the merits has been entered. This judgment is final and cannot be challenged in this tribunal. See *Federated Dep't Stores, Inc. v. Motie*, 452 U.S. 394, 398 (1981) ("A final judgment . . . precludes the parties or their privies from relitigating issues that were or could have been raised in that action."). Accordingly, pursuant to TBMP §510.02(b), Cancellation No. 24,108 should now be resumed in order to give final effect to the Cancellation Order.

Cubaexport should be substituted as the respondent in the resumed cancellation proceeding pursuant to TBMP § 512 because the assignments of the U.S. HAVANA CLUB Registration have been stricken from the USPTO's records and HCH, the respondent of record in that proceeding, never owned the registration at issue. The only party, under the mandate of the Cancellation Order, with an arguable interest in Registration No. 1,031,651 when the cancellation proceeding was originally brought was Cubaexport. Moreover, the USPTO now erroneously lists Cubaexport as the owner of said registration and on January 17, 2002, served Cubaexport with its Notice of that date. Therefore, Cubaexport should be substituted as the respondent since Cubaexport, not HCH, is the real party-in-interest.

B. Summary Judgment Is Warranted And The USPTO Must Cancel The Extant U.S. HAVANA CLUB Registration As It Was Not Renewed By Cubaexport Prior To The Expiration Of The Statutory Renewal Period

Summary judgment is appropriate where "there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." Rule 56(c), Fed. R. Civ. P. The summary judgment procedure is regarded as "a salutary method of disposition," and the Board does not hesitate to dispose of cases on summary judgment when appropriate. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1562 (Fed. Cir. 1987); TBMP § 528.01.

Bacardi, as movant, must show that "there is an absence of evidence to support the nonmoving party's case." *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). When the moving party has carried its burden, the nonmoving party "must do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita Elec. Indus. Co. Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). Rule 56(e) "requires the nonmoving party to go beyond the pleadings and by [its] own affidavits, or by the 'depositions, answers to interrogatories, and admissions on file,' designate 'specific facts showing that there is a genuine issue for trial.'" *Celotex*, 477 U.S. at 324. The dispositive facts here are beyond challenge.

The Cancellation Order pursuant to 15 U.S.C.A. § 1119 (West 1997) states: (a) that HCH's claimed rights as the registrant of the U.S. HAVANA CLUB Registration are canceled (*see* Cancellation Order at ¶ 8); (b) that HCH never acquired any ownership rights whatsoever in that registration (*id.* at ¶ 6); and (c) that the assignments were null and void (*id.* at ¶ 4).⁶ Under the statutory scheme for maintaining marks set forth in the Lanham Act, these

⁶ The term "registrant" both in its ordinary sense and as used in the Lanham Act connotes ownership of the registered mark and the related federal registration. *cf.* 15 U.S.C.A. § 1051(a) (West 1997) (emphasis added) ("The *owner* of a trademark used in commerce

rulings require that Registration No. 1,031,651 of the HAVANA CLUB mark be stricken in its entirety from the USPTO's records. *See Brittingham v. Jenkins*, 914 F.2d 447, 458 (4th Cir. 1990) (successful challenge to registrant's ownership of mark led to cancellation of registration).

The USPTO deleted the assignments to HCH from the USPTO records and also, without referring to this action in its Notice, deleted HCH's name as the holder of the U.S. HAVANA CLUB Registration. But the USPTO, *sub silentio*, apparently regarded HCH's renewal application as valid. However, the renewal affidavit filed by HCH must also be treated as a nullity because if HCH was not the registrant and never acquired any ownership interest of any kind in the subject registration -- as the District Court decided -- then HCH could not as matter of law renew that application. HCH's renewal application was a dead letter just like the assignments, so the U.S. HAVANA CLUB Registration expired in 1996. Consequently, there can be no valid U.S. Registration No. 1,031,651 in the name of Cubaexport on the USPTO records now, more than five years after the statutory period for renewal lapsed.

Since Cubaexport was the sole claimant to rights in the U.S. HAVANA CLUB Registration, that registration would have had to have been renewed by Cubaexport no later than April 27, 1996. The statutory time period set forth in the Lanham Act, 15 U.S.C.A. § 1059 (West 1997), requires that a complete renewal application must be filed as follows:

- (a) Each registration may be renewed for periods of ten years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto, a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any

may apply to register his or her trademark ..."); 15 U.S.C.A. § 1057(b) (West 1997) ("A certificate of registration of the mark ... shall be *prima facie* evidence ... of the registrant's ownership of the mark.").

intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein prescribed.⁷

The U.S. HAVANA CLUB Registration for "rum" issued for a period of 20 years on January 27, 1976. Cubaexport was, therefore, obligated to file its renewal application during the period beginning on July 27, 1995 and ending, with the benefit of the three month additional extension period, on April 27, 1996.⁸

No renewal affidavit has ever been filed by Cubaexport as is ascertainable by judicial notice of the USPTO's own records. Although Cubaexport was notified by the District Court of the Summary Judgment against HCH, Cubaexport has not, since the Cancellation Order was issued, even tried to file a renewal application of its own (The undisputed facts established in the *Havana Club* litigation shows Cubaexport could not make a justifiable non-use declaration without perjuring itself). The USPTO cannot under the Lanham Act accept a renewal affidavit from Cubaexport for the U.S. HAVANA CLUB Registration that was filed after the April 27, 1996 statutory deadline.

Cubaexport's indisputable failure to file a renewal application is fatal to any claim that the U.S. HAVANA CLUB Registration should somehow be metaphysically maintained in Cubaexport's name. The ineluctable fact is that Cubaexport did not apply to renew the mark on or before April 27, 1996. In *In re Holland Am. Wafer Co.*, 737 F.2d 1015, 1018 (Fed. Cir. 1984), the Federal Circuit held that for a registration to be renewed, a complete renewal application

⁷ 15 U.S.C.A. § 1059 was modified effective October 30, 1999 in accordance with the Trademark Law Treaty Implementation Act. As of the time that the renewal application had to be filed for the U.S. HAVANA CLUB Registration, however, the statutory language noted above was in effect.

must be submitted within the statutorily-prescribed time period. The contents of the renewal application, the court stated, must include, *inter alia*, an affidavit by the owner of the mark. "Timeliness set by statute is not a minor technical defect which can be waived by the Commissioner." *Id.* at 1018.

While the Director, under Trademark Rules 2.146(a)(5) and 2.148, has some limited discretion in an "extraordinary situation" to waive "any requirement of the rules . . . not being a requirement of the Statute," 37 C.F.R. § 2.148; *see also* 37 C.F.R. § 2.146(a)(5); *In re Caldon Co. Ltd. Partnership*, 37 U.S.P.Q.2d 1539, 1541 (Comm'r Pats. 1996), the Director has no power to waive an explicit statutory requirement such as the deadline for filing renewal applications. *See id.*; *see also In re Trademark Application of Ronald George Dandar*, No. 97-503, 2000 TTAB LEXIS 317, at*1 (T.T.A.B. May 11, 2000). Specifically, "[t]he Commissioner cannot extend, suspend, or waive the time for filing a complete application for renewal for any reason." *In re Trademark Application of Ronald George Dandar*, 2000 TTAB LEXIS 317, at*4; *see also In re Culligan Int'l Co.*, 915 F.2d 680, 681 (Fed. Cir. 1990); *In re Holland Am. Wafer Co.*, 737 F.2d at 1018; *In re Michael Stern & Co., Inc.*, 199 U.S.P.Q. 382, 383 (Comm'r Pats. 1978); *Ex parte Firmenich & Co.*, 137 U.S.P.Q. 476, 477 (Comm'r Pats. 1963).

In any event, Cubacexport's failure to file a renewal application was no simple mistake. The assignment from Cubacexport to HCH was held by the District Court to violate U.S. law and regulations enforcing the total trade embargo on Cuba, so there are no equitable factors favoring Cubacexport. HCH's own filing of a renewal affidavit was not inadvertent; it was deliberate and was intertwined with a knowing violation of U.S. law. The renewal application by

⁸ The statutory period for filing a renewal application for a registration that issued or was last renewed prior to November 16, 1989 is twenty years from the date of issuance or the last renewal. *See* 37 C.F.R. § 2.181(a)(1).

HCH, a stranger to the registration, was ineffective and null and void as a matter of law just as the assignments to HCH were treated as null and void and of no force and effect. There is no basis whatsoever in law or equity for the USPTO to regard HCH's filing as Cubaexport's.

Only Cubaexport, the putative owner of the U.S. HAVANA CLUB Registration in 1996, lawfully had the power to file the renewal affidavit. The case of *In re Caldon Co. Ltd. Partnership*, 37 U.S.P.Q.2d 1539 (Comm'r Pats. 1996), dealt with the issue of whether the filing of a declaration pursuant to Section 8 of the Lanham Act, 15 U.S.C.A. § 1058, executed by an officer of an affiliated corporation of the actual owner could be "corrected" after the expiration of the statutory time period for making such a filing. The registration in question, which issued on April 4, 1989, had been assigned by the original registrant to Caldon Company Limited Partnership ("Caldon Partnership"). The assignment to Caldon Partnership was duly recorded in the USPTO. Caldon Partnership was statutorily required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the date of registration (i.e., between April 4, 1994 and April 4, 1995). On September 19, 1994, a declaration of continued use was inadvertently filed by Caldon, Inc., a separate legal entity from Caldon Partnership. By letter dated March 16, 1995, the Affidavit Renewal Examiner at the USPTO notified Caldon, Inc. that acceptance of the renewal affidavit was withheld because the records of the USPTO showed title to the registration in the name of Caldon Partnership but added that evidence of ownership in the name of Caldon, Inc. could be submitted. In a petition filed May 30, 1995 (after the close of the sixth year), Caldon Partnership asked that the USPTO accept the originally-filed declaration as "corrected" by the actual owner--Caldon Partnership. The petition was denied and the registration ordered canceled because:

That statute specifically requires that the affidavit be filed by 'the registrant,' prior to the expiration of the sixth year after the date of

registration. The term 'registrant' includes both the original registrant, and a person who has acquired ownership through proper transfer of title. . . . [I]f the party who filed the affidavit was not the owner of the registration at the time the affidavit was filed, a substitute affidavit in the name of the true owner cannot be filed unless there is time remaining in the statutory filing period.

Id. at 1541 (emphasis added) (citing *In re Precious Diamonds, Inc.*, 635 F.2d 845 (C.C.P.A. 1980); *In re Weider*, 212 U.S.P.Q. 947 (Comm'r Pats. 1981)).

The Cancellation Order mandates that HCH cannot be treated as the "owner" of the U.S. HAVANA CLUB Registration when the renewal was filed, because HCH never obtained any ownership interest in it ever. Moreover, the Director, as the cited cases show, has no authority to accept a new or corrected renewal application by Cubaexport now, as the statutory deadline for such a filing passed over five years ago. Cubaexport has never bothered to attempt to renew the U.S. HAVANA CLUB Registration, and there is no reason to conclude that Cubaexport claimed or claims any U.S. rights in the HAVANA CLUB mark after the abortive transfers.

Indeed, the record in the related *Havana Club* federal litigation establishes that Cubaexport, could not truthfully have filed in 1996 a verified declaration showing excusable nonuse, which declaration was the *sine qua non* of a proper renewal. Cubaexport had contractually bargained away the right to sell HAVANA CLUB rum everywhere in the world in the Convenio (the Joint Venture Agreement between the Castro government and Pernod), and the sworn testimony of Mr. Thierry Jacquillat, Pernod's CEO, confirmed that "[u]nder the Convenio, Pernod Ricard [was] the exclusive distributor worldwide of the HAVANA CLUB brand" (*See* District Court Trial Tr., Feb. 5, 1999, at p. 1460, attached as Exhibit D) throughout the renewal period. Therefore, Cubaexport could not have sworn that but for the Cuban embargo it was ready and able to sell HAVANA CLUB rum here. Accordingly, the essential requirement for a

valid renewal, that is, a truthful declaration of excusable nonuse, was not met and could not now be met by Cubaexport.

V.

CONCLUSION

For the reasons set forth above, Bacardi respectfully requests that the USPTO rectify its records by expunging all reference to U.S. Registration No. 1,031,651 of the mark HAVANA CLUB for rum.

Dated: March 15, 2002
New York, New York

Respectfully Submitted,
KELLEY DRYE & WARREN LLP

By: _____
William R. Golden, Jr.
Michelle M. Graham

101 Park Avenue
New York, New York 10178
(212) 808-7800

Attorneys for Petitioners
Bacardi & Company, Ltd. (formerly Galleon,
S.A.) and Bacardi U.S.A., Inc. (formerly
Bacardi-Martini U.S.A., Inc.)

Of Counsel:

Frederick J. Wilson, III, Esq.

FOIA 0062

CERTIFICATE OF MAILING

EXPRESS MAIL LABEL NO.: EJ624345515US

DATE OF DEPOSIT: March 15, 2002

The undersigned hereby certifies that on March 15, 2002 a copy of the foregoing NOTICE OF MOTION and MEMORANDUM OF LAW IN SUPPORT OF PETITIONERS' MOTION TO RESUME PROCEEDINGS, TO SUBSTITUTE PARTIES AND FOR SUMMARY JUDGMENT is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to Box TTAB-No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Michelle M. Graham

FOIA 0063

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 15, 2002 a copy of the foregoing NOTICE OF MOTION and MEMORANDUM OF LAW IN SUPPORT OF PETITIONERS' MOTION TO RESUME PROCEEDINGS, TO SUBSTITUTE PARTIES AND FOR SUMMARY JUDGMENT has been served upon:

(A) Charles S. Sims, Esq. of Proskauer Rose LLP by depositing a true copy thereof with Federal Express addressed to the aforesaid attorney at 1585 Broadway, New York, New York 10036, the address designated by said attorney for that purpose; and

(B) Michael Krinsky, Esq. of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, PC by depositing a true copy thereof with Federal Express addressed to the aforesaid attorney at 740 Broadway, New York, New York 10003, the address designated by said attorney for that purpose.

Dated: March 15, 2002

Michelle M. Graham

FOIA 0064

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An extra section break has been inserted above this paragraph. Do not delete this section break if you plan to add text after the Table of Contents/Authorities. Deleting this break will cause Table of Contents/Authorities headers and footers to appear on any pages following the Table of Contents/Authorities.

FOIA 0066

THESE ARE ONLY SOME KEY CAPTIONS FROM THE MOTION FOR SUMMARY JUDGMENT FILED FRIDAY MARCH 15TH, 2002 WITH PTO.

Cancellation No. 24,108 Should Be Resumed With Cubaexport Substituted As The Respondent

Cancellation No. 24,108 was suspended pending the outcome of the federal litigation between the parties that resulted in the Partial Judgment in *Havana Club Holding, S.A. v. Galleon S.A.*, 96 Civ. 9655 (SS), which is at issue here. That litigation has long since concluded, appeals have been taken, and a final decision on the merits has been entered. This judgment is final and cannot be challenged in this tribunal. Accordingly, pursuant to TBMP §510.02(b), Cancellation No. 24,108 should now be resumed in order to give final effect to the Cancellation Order.

Cubaexport should be substituted as the respondent in the resumed cancellation proceeding pursuant to TBMP § 512 because the assignments of the U.S. HAVANA CLUB Registration have been stricken from the USPTO's records and HCH, the respondent of record in that proceeding, never owned the registration at issue. The only party, under the mandate of the Cancellation Order, with an arguable interest in Registration No. 1,031,651 when the cancellation proceeding was originally brought was Cubaexport. Moreover, the USPTO now erroneously lists Cubaexport as the owner of said registration and on January 17, 2002, served Cubaexport with its Notice of that date. Therefore, Cubaexport should be substituted as the respondent since Cubaexport, not HCH, is the real party-in-interest.

But the USPTO, *sub silentio*, apparently regarded HCH's renewal application as valid. However, the renewal affidavit filed by HCH must also be treated as a nullity because if HCH was not the registrant and never acquired any ownership interest of any kind in the subject registration – as the District Court decided – then HCH could not as matter of law renew that application. HCH's renewal application was a dead letter just like the assignments, so the U.S. HAVANA CLUB Registration expired in 1996. Consequently, there can be no valid U.S. Registration No. 1,031,651 in the name of Cubaexport on the USPTO records now, more than five years after the statutory period for renewal lapsed

The U.S. HAVANA CLUB Registration for "rum" issued for a period of 20 years on January 27, 1976.

Cubaexport was, therefore, obligated to file its renewal application during the period beginning on July 27, 1995 and ending, with the benefit of the three month additional extension period, on April 27, 1996.

No renewal affidavit has ever been filed by Cubaexport as is ascertainable by judicial notice of the USPTO's own records. Although Cubaexport was notified by the District Court of the Summary Judgment against HCH, Cubaexport has not, since the Cancellation Order was issued, even tried to file a renewal application of its own (The undisputed facts established in the *Havana Club* litigation shows Cubaexport could not make a justifiable non-use declaration without perjuring itself). The USPTO cannot under the Lanham Act accept a renewal affidavit from Cubaexport for the U.S.

HAVANA CLUB Registration that was filed after the April 27, 1996 statutory deadline.

Cubaexport's indisputable failure to file a renewal application is fatal to any claim that the U.S. HAVANA CLUB Registration should somehow be metaphysically maintained in Cubaexport's name. The ineluctable fact is that Cubaexport did not apply to renew the mark on or before April 27, 1996.

The renewal application by HCH, a stranger to the registration, was ineffective and null and void as a matter of law just as the assignments to HCH were treated as null and void and of no force and effect. There is no basis whatsoever in law or equity for the USPTO to regard HCH's filing as Cubaexport's.

Only Cubaexport, the putative owner of the U.S. HAVANA CLUB Registration in 1996, lawfully had the power to file the renewal affidavit.

Moreover, the Director, has no authority to accept a new or corrected renewal application by Cubaexport now, as the statutory deadline for such a filing passed over five years ago.

Indeed, the record in the related *Havana Club* federal litigation establishes that Cubaexport, could not truthfully have filed in 1996 a verified declaration showing excusable nonuse, Cubaexport had contractually bargained away the right to sell HAVANA CLUB rum everywhere in the world in the Convenio. Accordingly, the essential requirement for a valid renewal, that is, a truthful declaration of excusable nonuse, was not met and could not now be met by Cubaexport.

Muniz, Carlos

From: Freedman, Melissa [freedmm@SSONet.sso.org]

Sent: Tuesday, March 19, 2002 12:00 PM

To: Jon Dudas

Subject: Update--Bacardi

Hi Jon,

As an FYI--I wanted to let you know that our office heard from Mr. Jorge Rodriguez Marquez, President of Bacardi, yesterday. He informed us that Bacardi filed a motion for cancellation of the CubaExport registration on summary judgment with the Patent and Trademark Office last Friday, March 15th.

If we can help this matter in any way, please let me know. Thanks so much for your time and follow-up calls. It is appreciated.

Thanks,

Melissa Freedman
Office of Governor Jeb Bush
(202) 624-5885

Muniz, Carlos

From: Nina Oviedo [oviedon@sso.org]
Sent: Tuesday, April 09, 2002 6:32 PM
To: Governor Bush (E-mail); Kathleen Shanahan (E-mail); Frank R. Jimenez (E-mail)
Cc: Melissa Freedman (E-mail)
Subject: FW: Bacardi Issue-Continued

Pls see Melissa's update below. We would be happy to make appropriate contacts...pls advise. Nina

-----Original Message-----

From: Freedman, Melissa [mailto:freedmm@SSONet.sso.org]
Sent: Tuesday, April 09, 2002 6:12 PM
To: Oviedo, Nina
Subject: Bacardi Issue-Continued

Nina,

Jorge Rodriguez, President of Bacardi, just emailed us today, to give us an update on his problems with the Patent and Trademark Office and the Office of Foreign Asset Control...and to ask for help.

Patent and Trademark Office Issue-- At a meeting that Bacardi and our office attended, with representatives from the Patent Office, Bacardi was told that in order to obtain their license and registration for Havanna Club Holdings, Bacardi would have to request that the Patent Office expunge CubaExport/Pernod's registration of the company. After requesting the cancellation of the registration (3/15/02), Bacardi has now been told that the Patent Office has granted Cuba Export/Pernod's request to extend the comment period for the cancellation, by 30 days. Bacardi is understandably upset, as they feel this issue has been dragged out for years.

Office of Foreign Asset Control Issue--Bacardi has been told for the last six months that a pending license application for Havanna Club Holdings that Pernod applied for in 1997, will finally be denied. However, no action has been taken by the Foreign Asset Office. Bacardi is frustrated because they feel that if the license application is not denied, the Patent Office may hold up cancellation of CubaExport/Pernod's registration.

Mr. Rodriguez is requesting our help to put pressure on these two bureaucracies, where possible. He is in Washington today and tomorrow, and would like us to call.

Thanks. Melissa

Muniz, Carlos

From: Nina Oviedo [oviedon@sso.org]
Sent: Thursday, April 18, 2002 7:36 PM
To: Brian Yablonski (E-mail); Frank R. Jimenez (E-mail); KaS (E-mail)
Subject: FW: Bacardi's Problems @ PTO and OFAC

Importance: High



plc16827.pcx



plc09961.pcx

How far do you want us to take this? Nina

-----Original Message-----

From: Melissa Freedman [mailto:freedmm@sso.org]
Sent: Thursday, April 18, 2002 5:13 PM
To: Nina Oviedo
Subject: FW: Bacardi's Problems @ PTO and OFAC
Importance: High

We never heard back from your April 9th email asking Tallahassee for some direction on the issue.

Should we resend? Or hold off on taking action?

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Thursday, April 18, 2002 5:08 PM
To: oviedon@sso.org; freedmm@sso.org
Subject: Bacardi's Problems @ PTO and OFAC
Importance: High

Dear Nina and Mellissa,

ANY NEWS FROM YOUR END?????????

This conflict is taking a life of its own and is dragging us to defend ourselves and our rights publicly.

This administration should be actively opposed to having American businesses UNFAIRLY hurt and abused by career bureaucrats who are only defending the interest of those who broke the law.

Bacardi is a standing symbol of doing things the right way and from our beginnings in Cuba 140 years ago to our rebirth in Miami in the 1960's we have shown our immediate Cuban American community in Miami and the world in general that when you do things the right way, things fall in place at the end.

I hope this case ends according to that principal, although so far Castro and Pernod are winning.

Jorge

----- Forwarded by J Rodriguez-Marquez/BMUSA/Bacardi on 04/18/2002 04:23 PM

J
Rodriguez-Marq

To: "Melissa Freedman"

FOIA 0071

<freedmm@sso.org>

uez

cc: oviedon@sso.org

Subject: RE: Bacardi's Problems

@ PTO and OFAC(Document link: J
04/09/2002
12:39 PM

Rodriguez-Marquez)

(Embedded
image moved (Embedded image moved to file: pic09961.pcx)
to file:
pic16827.pcx)

Dear Melissa,

"Business as Usual" is all I can say about Patent and Trademark Office's behavior in our case.

Once again and unfortunately, we do not see ANY favorable reaction from PTO to our case.

The TTAB's response to our actions of March 15th, (as copy of my e-mail to you below) has been to grant Pernod-Ricard their requested extension of 30 days. Therefore, ANYTHING Pernod asks from PTO's administration they get, and Bacardi is left to wait, and wait.

I do not know IF THERE IS ANYTHING ELSE, that Bacardi can do to receive a FAIR treatment from Patent and Trademark office. Perhaps, we need to learn from Pernod, they seem to be getting PTO's attention.

Regarding, the second issue, the one at OFAC (Office of Foreign Asset Control at Treasury), we have heard from Ambassador Larson (State Department) many times during the last six months that the pending license application which Pernod applied for in 1997 will be finally denied, but that is still pending (after almost five years) and as I am sure you remember, Eleanor Maltzer from PTO mentioned it as a possible winning card in Pernod's game. That application NEEDS to be denied, but here again Pernod is still receiving help from this other side of our government.

I WISH SOMEONE COULD TELL ME WHAT IS BACARDI DOING WRONG??????????????

Our business is STILL being disturbed, by the lack of FAIR actions from our government, while the Federal courts and WTO tells us we are on the side of right.

Frustrating.

I am in Washington DC today and tomorrow, call my cell if you have any comments or ideas. (305)613-5099

Regards,
Jorge

"Melissa
Freedman"

<jrodriguez-marquez@bacardi.com>
<freedmm@sso.

To: "J Rodriguez-Marquez"

cc:

FOIA 0072

&Trademark Office

org>

Subject: RE: Bacardi and Patent

03/22/2002
05:26 PM

Hi Jorge,

I apologize for just getting back to you--we have been so busy, though it always seems that way! I received your voicemail--the night we received your email about filing the motion to cancel Cuba Export's registration, we emailed Jon Dudas at PTO to let him know that you had taken that step. So, we have made the contact already, and will now await their response to your filing.

Please let us know how things progress, and do not hesitate to call or email.

Have a pleasant weekend,
Melissa Freedman
Office of Governor Jeb Bush
(202) 624-5685

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Monday, March 18, 2002 4:57 PM
To: oviedon@sso.org; freedmm@sso.org
Subject: Bacardi and Patent &Trademark Office
Importance: High

Dear Nina and Melissa,

This past Friday, March 15th our lawyers Kelley Drye & Warren of New York, filed with Patent And Trademark Office a motion for cancellation of the CubaExport registration on Summary Judgment.

Below you can find two attachments:

one is the complete set of documents as filed Friday with PTO;

the other shows most (but not all) of the key points extracted from the documents filed with PTO, which I selected only for your easy reading.

(See attached file: PTO-Summary Judgment-3-15-02.DOC) (See
attached file: PTO- Key Captions from Summary Judgment-3-15-02.doc)

Since our meeting at PTO, Monday February 25th our lawyers have also filed an official complaint with PTO showing them that they DID NOT notify Bacardi of their decision dated January 15th, even though they have insisted they did. Last week PTO finally issued a formal reply to us admitting that in fact the notification to Bacardi was never sent out. It is the second time in 18 months that PTO finds a problem notifying Bacardi on issues of Havana Club.

Assuming that now PTO would "want to" act equitably and follow the straight line, (I will not hold my breath on that), this new request from us now asking to cancel Cuba Export from their records should put the final end to this ever lasting problem.

Cuba Export, as you might remember is Castro's government entity which registered Havana Club in the US in 1976 and later sold all its rights to Havana Club Holdings (HCH) which is the partnership between Castro and Pernod-Ricard, the French beverage company. HCH lost its rights in Federal Court and Cuba Export willingly lost theirs when they sold them to HCH.

Would you please, help us by making sure that Patent and Trademark Office's Mr. Dudas knows that all they need to do now is be very much aware of this motion for summary judgment, so that it can go through its normal process without any undue negative "influence" from certain parties known to us.

Let me know if you have any questions.

Jorge

Muniz, Carlos

From: Jeb Bush [jeb@jeb.org]
Sent: Saturday, April 20, 2002 8:43 AM
To: Oviedo, Nina
Subject: FW: BACARDI NEEDS YOUR HELP

Importance: High

any thoughts on this?

Jeb Bush

Please note: Florida has a very broad public records law.
Most written communications to or from state officials
regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Thursday, April 18, 2002 5:36 PM
To: Jeb Bush
Subject: BACARDI NEEDS YOUR HELP
Importance: High

DEAR JEB,

UNFORTUNATELY NOTHING HAS CHANGED SINCE THE MEETING WITH PTO FEBRUARY
25TH.

BUREAUCRATS AT PTO CONTINUE TO WIN THE BATTLE FOR FIDEL AND PERNOD.

THIS CONFLICT IS TAKING A LIFE OF ITS OWN AND BACARDI IS BEING FORCED
TO
DEPEND ITS CASE PUBLICLY

IT IS EMBARRASSING TO US THAT PEOPLE, EVEN IN MIAMI, BELIEVE THAT IT IS
BACARDI, NOT SOME US GOVERNMENT BUREAUCRATS, WHO ARE THE REASON FOR
CASTRO
AND PERNOD TO STILL CLAIM THE HAVANA CLUB BRAND.

ONCE PTO ACTS FAIRLY AND PROFESSIONALLY FOLLOWING US LAWS BACARDI'S
PROBLEMS WILL BE OVER.

PLEASE, SOMEONE NEEDS TO TELL PTO TO STOP INTERFERING.

JORGE

FOIA 0075

Muniz, Carlos

From: Nina Oviedo [oviedon@sso.org]
Sent: Wednesday, April 24, 2002 10:01 AM
To: 'Jeb Bush'; 'Brian Yablonski (E-mail)'; 'Frank R. Jimenez (E-mail)'; 'KaS (E-mail)'
Cc: 'Melissa Freedman (E-mail)'

Subject: RE: Bacardi Update

Melissa is setting up another set of meetings with the Patent Office and State Dept. After those meetings we may need you to personally chime in. Melissa spoke with Jorge yesterday....Jorge will make his schedule available to us at any time. After those meetings we'll adjust the strategy as necessary.

We'll follow-up after meetings. Nina.

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Tuesday, April 23, 2002 10:09 PM
To: Nina Oviedo; Brian Yablonski (E-mail); Frank R. Jimenez (E-mail); KaS (E-mail)
Cc: Melissa Freedman (E-mail)
Subject: RE: Bacardi Update

what do we need to do?

Jeb Bush

Please note: Florida has a very broad public records law. Most written communications to or from state officials regarding state business are public records available to the public and media upon request. Your e-mail communications may therefore be subject to public disclosure.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Tuesday, April 23, 2002 4:55 PM
To: Jeb Bush; Brian Yablonski (E-mail); Frank R. Jimenez (E-mail); KaS (E-mail)
Cc: Melissa Freedman (E-mail)
Subject: Bacardi Update

Governor---you asked about Bacardi. Below is an update from Melissa.

Jorge is in town this week and I've asked Melissa to touch base with him. We will follow-up with one more meeting at the Patent Office.

Fyi--- Former Congressman Jim Rogan (R-CA) was recently confirmed by the Senate as the Undersecretary for Intellectual Property and Director of the Patent Office. Melissa and Jorge previously met with the Deputy Undersecretary and Deputy Director. After another meeting, we might need to come back to you for an additional push. We'll write again after our next meeting.

Nina.

-----Original Message-----

From: Freedman, Melissa [mailto:freedmm@SSONet.sso.org]
Sent: Tuesday, April 23, 2002 4:16 PM
To: Oviedo, Nina
Subject: Bacardi Issue Continued...

Nina,

Below is a summary of Bacardi's problems with the Patent and Trademark Office and the Office of Foreign Asset Control...in response to the email Jorge Rodriguez sent to the Governor, seeking his help.

Patent and Trademark Office Issue-- At a meeting that Bacardi and our office attended, with representatives from the Patent Office, Bacardi was told that in order to obtain their license and registration for Havanna Club Holdings, Bacardi would have to request that the Patent Office expunge CubaExport/Pernod's registration of the company. After requesting the cancellation of the registration, Bacardi has now been told that the Patent Office has granted CubaExport/Pernod's request to extend the comment period for the cancellation, by 30 days. Bacardi is understandably upset, as they feel this issue has been dragged out for years.

Office of Foreign Asset Control Issue--Bacardi has been told for the last six months that a pending license application for Havanna Club Holdings that CubaExport/Pernod applied for in 1997, will finally be denied. However, no action has been taken by the Foreign Asset Office. Bacardi is frustrated because they feel that if the license application is not denied, the Patent Office may hold up cancellation of CubaExport/Pernod's registration.

Mr. Rodriguez is requesting our help to put pressure on these two bureaucracies, where possible.

Thanks. Melissa

Muniz, Carlos

From: Kathleen Shanahan [kathleen@jeb.org]
Sent: Friday, April 26, 2002 8:55 AM
To: Jeb Bush; Oviedo, Nina
Subject: RE: BACARDI NEEDS YOUR HELP

nina and i will discuss
we may need to move up the food chain

-----Original Message-----

From: Jeb Bush [mailto:jeb@jeb.org]
Sent: Thursday, April 25, 2002 9:03 PM
To: Oviedo, Nina (work) (E-mail); Kathleen Shanahan (E-mail)
Subject: FW: BACARDI NEEDS YOUR HELP
Importance: High

Jeb Bush

Please note: Florida has a very broad public records law.
Most written communications to or from state officials
regarding state business are public records available to the
public and media upon request. Your e-mail communications
may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Thursday, April 25, 2002 7:17 AM
To: Jeb Bush
Subject: RE: BACARDI NEEDS YOUR HELP
Importance: High

THANK YOU VERY MUCH FOR YOUR SUPPORT.

I HAVE ALREADY RECEIVED A CALL FROM YOUR WASHINGTON OFFICE YESTERDAY
AFTERNOON WHILE I WAS FLYING BACK FROM WASHINGTON DC.

IF ALAN LARSON (DEPUTY SECRETARY OF STATE) WOULD HAVE ALREADY DENIED, AS
HE
SHOULD HAVE AND AS HE HAS PROMISED TO DO, THE PENDING "OFAC" LICENSE
APPLICATION FROM PERNOD/CUBA, (GRANTING IT WOULD GO AGAINST USA LAW),
THIS
WHOLE PROBLEM AT PTO WOULD HAVE BEEN RESOLVED BY NOW.

I MET WITH LARSON TUESDAY MORNING AND HE ASKED ME FOR "A LITTLE MORE
TIME
TO ACT". .
I TOLD HIM HE HAS HAD ON HIS SIDE US LAWS AS WELL AS FIVE YEARS OF TIME
TO
ACT. I REMINDED HIM THAT AT OUR PREVIOUS MEETING FEB. 14 HE PROMISED ME
TO
ACT "IN A MATTER OF WEEKS", BUT THAT WAS OVER TWO MONTHS AGO.

LARSON'S ONLY PROBLEM IS THAT HE HAS A VERY SERIOUS HANDICAP
UNDERSTANDING
THE VERB TO ACT.

JORGE

"Jeb Bush"

<jeb@jeb.org>
<jrodriguez-marquez@bacardi.com>

To: "J Rodriguez-Marquez"

cc:

04/24/2002

Subject: RE: BACARDI NEEDS

YOUR HELP

06:39 AM

My Washington office just briefed me on the status of this and we will push to get this resolved.

Jeb Bush

Please note: Florida has a very broad public records law. Most written communications to or from state officials regarding state business are public records available to the public and media upon request. Your e-mail communications may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Thursday, April 18, 2002 5:36 PM
To: Jeb Bush
Subject: BACARDI NEEDS YOUR HELP
Importance: High

DEAR JEB,

UNFORTUNATELY NOTHING HAS CHANGED SINCE THE MEETING WITH PTO FEBRUARY 25TH.

BUREAUCRATS AT PTO CONTINUE TO WIN THE BATTLE FOR FIDEL AND PERNOD.

THIS CONFLICT IS TAKING A LIFE OF ITS OWN AND BACARDI IS BEING FORCED TO DEFEND ITS CASE PUBLICLY

IT IS EMBARRASSING TO US THAT PEOPLE, EVEN IN MIAMI, BELIEVE THAT IT IS

BACARDI, NOT SOME US GOVERNMENT BUREAUCRATS, WHO ARE THE REASON FOR
CASTRO
AND PERIOD TO STILL CLAIM THE HAVANA CLUB BRAND.

ONCE PTO ACTS FAIRLY AND PROFESSIONALLY FOLLOWING US LAWS BACARDI'S
PROBLEMS WILL BE OVER.

PLEASE, SOMEONE NEEDS TO TELL PTO TO STOP INTERFERING.

JORGE

FOIA 0080

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Friday, May 10, 2002 6:06 PM
To: Oviedo, Nina; Freedman, Melissa
Subject: ANY NEWS

Dear Nina and Melissa,

Any news since our last contact ?

Since my last meeting with Larson (State Dpt.) April 23rd when he told me he needed a little bit more time to act on the denial of the pending application at OFAC (Treasury) which Cuba/Pernod applied for in 97, I have heard nothing at all from his office. However, yesterday I visited with a friend at State who told me that Larson seems to be pushing his staff to move this issue forward, however, at a multi-agency meeting (PTO, OFAC, USTR and EA) called last week for this purpose lawyers from PTO and OFAC were more inclined to stall than to move.

If someone could have the determination and power to stop legal career bureaucrats from fabricating delays, this adverse and unfortunate government intervention into the life of a private business would end for us and for the government. It is costing plenty to both.

Regards,

Jorge

Slater Bayliss

From: Nina Oviedo [oviedon@sso.org]
Sent: Monday, May 13, 2002 10:38 AM
To: 'Yablonski, Brian'; 'Dana, Pam'; 'Jimenez, Frank'
Cc: 'Shanahan, Kathleen'; Jeb Bush; Melissa Freedman (E-mail)
Subject: RE: Trade legislation

Team-----We feel that Nelson's efforts are clearly political. We talked to his staff almost daily last week and no one mentioned the e-mail letter; of course they sent it through "standard processes" as opposed to delivering directly to Governor or us----the Gov gives his e-mail address to the world! Nelson should have it.

We have a call in for Bryant Hall, Graham's LD to see what Daschle may be telling Graham about amendments. We also have left a message for our WH contacts.

We spoke w/ USTR contacts this morning. A deal has been cut and Daschle and Lott will be opposing all amendments. USTR anticipates heavy debate Wed and Thurs w/ hopes of a vote on Thursday.

We also spoke with Andy LaVigne who understands the current situation and told us that he has talked to Graham and Nelson's staff and said, "If the deal is cut, offer the amendment, talk about it, and withdraw it." Andy takes the view that if we push too hard, we/citrus will hurt ourselves in future negotiations.

As soon as we have a few more pieces...we will call...to talk about whether we respond in writing. At this time, we feel that by responding we escalate the political rhetoric.

Melissa is currently working on the Bacardi letter and we'll have that to you later today for review. Nina.

-----Original Message-----

From: Yablonski, Brian [mailto:Brian.Yablonski@MyFlorida.com]
Sent: Friday, May 10, 2002 5:57 PM
To: Dana, Pam; Oviedo, Nina; Jimenez, Frank
Cc: Shanahan, Kathleen; 'jeb@jeb.org'
Subject: RE: Trade legislation

Nina, can you call Andy/Jennifer and find out what gives -- this is clearly the broader amendment -- did Citrus just ignore our counsel? any expectations subsequent to our conversations from last week?

Daschle and the White House have a deal -- so amendment just appears to be going through the motions.

Option 1: Do a letter back to the senators indicating support for tpa and support for a narrower amendment that applies to citrus, reiterate that we have contacted multiple parties on the issue, including grassley, and that we will be involved in trade negotiations and looking out for florida's interests.

Finally, expose Nelson in letter for his true intentions.

Option 2: Ignore the letter -- it is political and nothing else. If asked by reporters, we can state the above.

-----Original Message-----

From: Dana, Pam

FOIA 0082

Sent: Friday, May 10, 2002 4:21 PM
To: Oviedo, Nina; Jimenez, Frank; Yablonski, Brian
Cc: Shanahan, Kathleen
Subject: FW: Trade legislation

Citizen Services forwarded to us.

-----Original Message-----

From: Bill_Nelson@billnelson.senate.gov
[mailto:Bill_Nelson@billnelson.senate.gov]
Sent: Wednesday, May 08, 2002 7:48 PM
To: jeb.bush@myflorida.com
Subject: Trade legislation

Dear Governor Bush:

We are writing to seek your partnership in a matter of vital importance to the Florida citrus industry. We are contacting you by e-mail because our efforts to reach you by telephone late last week were unsuccessful.

In preparation for the Senate's final consideration of the Trade Promotion Authority bill, we drafted an amendment that would help ensure the Florida citrus industry is afforded fair treatment in future trade agreements. In essence, our amendment would prevent any negotiated reduction in the tariff on Brazilian frozen concentrated orange juice from taking effect until the Brazilian citrus industry ceases its unfair trade practices, specifically dumping.

In crafting this amendment, we have consulted closely with Florida Citrus Mutual, the Florida Department of Citrus and the Florida Department of Agriculture and Consumer Services, and we are assured this language has their consensus support. They and we agree our chances of success are maximized by an amendment that is broad enough to attract support from similarly situated industries - and Senators from affected states. That is why our amendment would benefit several other industries subject to unfair foreign competition, and not just the citrus industry. The amendment is attached below for your review.

In response to our calls to you, we received a memo from your staff informing us of your office's activities in support of the citrus industry. The memo indicates that, while your staff has had recent discussions with their counterparts in the Administration and in Congress, your last conversations with Administration officials were in February.

Now, with the bill on the Senate floor, we have spoken to dozens of our colleagues, as well to numerous senior Administration officials, on behalf of this crucial amendment. We have no doubt that you are an influential voice with this Administration and invite you to join our efforts to help Florida's citrus growers by seeking the support of the White House for the amendment. A signal from the White House that this amendment has its support could deliver enough Republican Senators' votes to ensure its passage.

Furthermore, we urge that you personally contact Senator Charles Grassley, the

FOIA 0083

Ranking Republican on the Senate Finance Committee, to request specifically that he support our amendment to the Trade Promotion Authority bill. Senator Grassley can be reached at (202) 224-3744.

Please call us at your first available opportunity to discuss our cooperative efforts and strategy to help our citrus growers. For Senator Graham, call (202) 224-3041, or for Senator Nelson, call (202) 224-5274.

Sincerely,

Bob Graham

Bill Nelson

To extend trade authorities procedures with respect to reciprocal trade agreements.

Referred to the Committee on _____ and ordered to be printed
Ordered to lie on the table and to be printed

AMENDMENTS intended to be proposed by Mr. NELSON of Florida, for himself and Mr. GRAHAM of Florida

Viz:

At the end of section 3(a), insert the following new paragraph:

(8) PRODUCTS SUBJECT TO ANTIDUMPING AND COUNTERVAILING DUTY
ORDERS.-Paragraph
(1) (A) shall not apply to a product that is the subject of an antidumping or countervailing duty order at the time of the agreement referred to in paragraph
(1), unless the agreement provides that as a term, condition, or qualification of the tariff concession, the tariff reduction will not be implemented before the date that is 1 year after the date of the termination or revocation of such antidumping or countervailing duty order with respect to all exporters of such product.

At the end of section 3(b), insert the following new paragraph:

(4) PRODUCTS SUBJECT TO ANTIDUMPING AND COUNTERVAILING DUTY
ORDERS.-Paragraph
(1) shall not apply to a product that is the subject of an antidumping or countervailing duty order at the time of the agreement referred to in paragraph
(1), unless the agreement provides that as a term, condition, or qualification of the tariff concession, the tariff reduction will not be implemented before the date that is 1 year after the date of termination or revocation of such antidumping or countervailing duty order with respect to all exporters of such product.

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]

Sent: Monday, May 13, 2002 5:28 PM

To: Oviedo, Nina

Subject: RE: BACARDI

The letter is coming along...I am waiting for dollar figures and employee numbers from Bacardi, to insert into the letter. Jorge was very excited about the Governor's letter to PTO. He is grateful, and thinks it will go a long way in clearing up the issue.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]

Sent: Monday, May 13, 2002 4:41 PM

To: Melissa Freedman (E-mail)

Subject: BACARDI

Melissa---pls update on bacardi....how's the letter coming? Nina

Melissa Freedman

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Tuesday, May 14, 2002 5:59 PM
To: freedmm@sso.org
Subject: RE: ANY NEWS

Importance: High

Follow Up Flag: Follow up
Due By: Wednesday, May 15, 2002 9:30 AM
Flag Status: Completed

Dear Melissa,

Havana Club Holdings is jointly owned by the Cuban government and Pernod-Ricard of France right now and always. We do not believe that CubaExport exists any more and we do not think that CubaExport was ever directly a part of Havana Club Holdings other than through the fact that CubaExport is or was also owned by the Cuban government itself.

Pernod-Ricard can not be the sole owner of Havana Club Holdings because HCH reflects ONLY a partnership to commercialize worldwide the Havana Club brand and the Cuban government IS the ONLY and sole owner of the distilleries, their production, and THE BRAND HAVANA CLUB itself. Pernod-Ricard, only through HCH, owns ONLY the rights to commercialize Havana Club, and has no other asset. Therefore, Pernod-Ricard without the Cuban government CAN NOT DO ANYTHING.

Pernod-Ricard approached the Havana Club original owners (those who were victims of Castro's confiscation) in 1993, after we terminated Pernod as our Bacardi rum distributor in France. They wanted to buy the Arechabalas (family name of original owners) rights, but failed. Then approached Castro and made a deal forming Havana Club Holdings. Bacardi and Arechabalas both wrote letters to Pernod warning them NOT to make a deal with Castro over stolen properties. Pernod reply ignoring the warnings.

After Pernod signed the deal with Castro, the Arechabalas came to Bacardi knowing that for many years we have tried to buy their rights without success.

They were looking for a way to be able to fight back now that this new and additional thief (Pernod) came to aggravate their own situation. We offer to buy and we closed our agreement verbally with them in 1995 and together agreed to start the fight by selling Havana Club made by us in the USA. The final documents were signed in 1997 after a lot of due diligence which the Arechabalas had to complete before they were able to give us clear ownership.

Melissa, the whole process at TTAB (part of PTO) is in "stay" right now pending the resolution of a federal litigation which we had to file against PTO this past March 15th complaining about PTO's incredible actions of January 15th of this year when they placed the registration on CubaExport's name. That means that PTO may answer you in the same way. HOWEVER, once Larson denies the OFAC license, we can then withdraw our legal suit against PTO and the whole process at TTAB (PTO) can move faster. We can not take a chance withdrawing the law suit when OFAC is still alive as a serious threat to our case.

All of that means, that the Governor's actions aimed at Larson or above, regarding the OFAC issue, could be much more effective today than those at PTO, for now.

Thanks for all your help. Call me or e-mail back with ANY questions.

Jorge

FOIA 0086

"Melissa
Freedman" To: "J Rodriguez-Marquez" <jrodriguez-marquez@bacardi.com>
<freedmm@ssso.org> cc:
Subject: RE: ANY NEWS

05/14/2002
02:38 PM
Please
respond to
freedmm

He'll,

Thanks for all of the information...I have a couple more questions for you.

-Is Havana Club Holdings jointly owned by CubaExport and Pernod right now?
Or is Pernod the only owner?
-When and How did Pernod come into the picture?
-When did you guys purchase the brand name from the original family
owners?

We are working on the letter to PTO, and would like to get it out ASAP.
After that is done, I will work on the other issue, to see how we can help
with OFAC.

Thanks, Melissa

-----Original Message-----
From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Monday, May 13, 2002 6:45 PM
To: freedmm@ssso.org
Subject: RE: ANY NEWS
Importance: High

Dear Melissa,

What you have here I believe is enough, although there is more "meat" but I
do not think you would want to complicate it.

I am not sure that what I personally would want to say in this letter can
be said at all, but if it could be, it would read something like:

"Bacardi has already done everything by the book and has done it correctly
and legally, now it is time for those career bureaucrats at PTO who are not
happy that Bacardi is right, to move out of the way and let justice be
finally delivered."

I will send you in a few minutes a draft for you to consider suggesting it
to the Governor on the case of the OFAC license which is hanging on
Larson's final decision.

Thank you for your help,

Jorge

"Melissa
Freedman" To: "J Rodriguez-Marquez"
<jrodriguez-marquez@bacardi.com>
<freedmm@sso.org> cc:
Subject: RE: ANY NEWS

05/13/2002
04:44 PM
Please
respond to
freedmm

Jorge...here is the re-worked paragraph. IF there are any facts wrong, or something that should be added, please do so.

Thanks!

Since 1995 Bacardi-Martini, USA, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's claimed rights to the Havana Club trademark. In 1960, Fidel Castro illegally confiscated the Havana Club brand from the family that created the company in 1934. (strikethrough: Then, in) In 1976, Castro transferred the brand name to CubaExport, a Cuban government-controlled company and registered it in the USA. Years later, in 1993 (strikethrough: the) a new company Havana Club Holdings, was created as a joint (strikethrough: ly) venture owned by the Cuban government and a French company called Pernod-Ricard who then claimed CubaExport's rights and applied for and was granted, legal registration of the brand for use in the United States. However, the Havana Club brand and assets, were purchased by Bacardi from the original and legitimate owners and is legally owned by Bacardi-Martini, USA, Inc. since 1995 as confirmed by US federal courts proceedings of 1997.

After the 1997 federal court ruling in favor of Bacardi which was reaffirmed in appeals reaching the US Supreme Court who decided in October of 2000, Bacardi is still waiting for PTO to finally end this process and give Bacardi its rights to the Havana Club trademark in the US.

Thanks for your help, Melissa

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Friday, May 10, 2002 6:06 PM
To: oviedon@sso.org; freedmm@sso.org
Subject: ANY NEWS

Dear Nina and Melissa,

Any news since our last contact ?

Since my last meeting with Larson (State Opt.) April 23rd when he told me he needed a little bit more time to act on the denial of the pending application at OFAC (Treasury) which Cuba/Pernod applied for in 97, I have heard nothing at all from his office. However, yesterday I visited with a friend at State who told me that Larson seems to be pushing his staff to move this issue forward, however, at a multi-agency meeting (PTO, OFAC, USTR and EB) called last week for this purpose lawyers from PTO and OFAC were more inclined to stall than to move.

If someone could have the determination and power to stop legal career bureaucrats from fabricating delays, this adverse and unfortunate

government intervention into the life of a private business would end for us and for the government. It is costing plenty to both.

Regards,

Jorge

Slater Bayliss

From: Nina Oviedo [oviedon@sso.org]
Sent: Wednesday, May 15, 2002 4:21 PM
To: Jeb Bush; Kathleen Shanahan (E-mail)
Cc: Melissa Freedman (E-mail)
Subject: Bacardi update

We have been in contact w/ Jorge everyday this week (it's like pulling teeth! Trying to get the facts straight). We're very close to a draft letter for your review but we want to have a phone conference—with the Undersecretary at State, Allan Larsen, who's helping Jorge. Allan will be returning from Russia tonight...we will speak with him tomorrow. Apparently the issue is under review by the National Security Council—we want to make sure that we're not stepping on anyone's toes.
Nina

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]
Sent: Tuesday, May 21, 2002 1:54 PM
To: Oviedo, Nina
Subject: Reminder-Bacardi

Nina, have you talked to Kathleen about the Bacardi issue yet?

Also, just a reminder to put out the weekly to LCIR.

FOIA 0091

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]
Sent: Tuesday, June 04, 2002 3:09 PM
To: Oviedo, Nina
Subject: Bacardi

Nina,

Any word on whether Tallahassee sent the Bacardi letter to the Patent and Trademark Office?

Thanks, Melissa

FOIA 0092

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]
Sent: Thursday, June 20, 2002 11:17 AM
To: Oviedo, Nina
Subject: FW: Letter to Commerce

Follow Up Flag: Follow up
Due By: Wednesday, June 19, 2002 9:00 PM
Flag Status: Flagged

FYI--

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
Sent: Wednesday, June 19, 2002 7:11 PM
To: freedmm@sso.org
Subject: Letter to Commerce

Dear Melissa,
THANK YOU VERY MUCH for sending me your fax Monday with the letter to Rogan.

I have heard that the Larson issue is now almost like a done deal and I hope that is true.

Please, keep me in your mind if you hear anything from either PTO or OFAC.
Thanks again,

Jorge

FOIA 0093

Muniz, Carlos

From: Canady, Charles T. [Charles.Canady@MyFlorida.com]
Sent: Friday, July 12, 2002 2:36 PM
To: Oviedo, Nina
Subject: RE: letter from Rogan

Nina--I'm glad to take the credit for Jon's good work, but he actually worked for then Judiciary Chairman Hyde. Have fun in Boise.

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@esso.org]
Sent: Friday, July 12, 2002 2:30 PM
To: Kathleen Shanahan (E-mail)
Cc: Governor Bush (E-mail); Jan Russo (E-mail); Melissa Freedman (E-mail); Charles Canady (E-mail)
Subject: FW: letter from Rogan

Kathleen, see Melissa's draft note from Gov to Rogan. Jon Dudas is a former Charles Canady staffer....has been very helpful to us on this issue. Nina.

Jan---pls format. Thanks.

Charles----fyi---your former staff's good efforts! Nina

-----Original Message-----

From: Melissa Freedman [mailto:freedmm@esso.org]
Sent: Friday, July 12, 2002 2:20 PM
To: Nina Oviedo
Subject: FW: letter from Rogan

Jim,

Thank you for the information you passed along regarding the Bacardi case. Your candor on the issue is appreciated. Along with the continued assistance of Mr. Jon Dudas, your attention to this matter has been very helpful. Please do not hesitate to call upon me, if I can be of service to you in the future.

Sincerely,

Jeb Bush

(Suggestion: Handwrite a hello from Kathleen and Charles.)

-----Original Message-----

From: Shanahan, Kathleen [mailto:Kathleen.Shanahan@MyFlorida.com]
Sent: Friday, July 12, 2002 1:26 PM
To: Oviedo, Nina; Shanahan, Kathleen
Cc: Freedman, Melissa; Governor Bush (E-mail)
Subject: RE: letter from Rogan

I wanted to be sure of the facts that is what I read in ltr as well. You all should send the ltr to Jorge as a follow on to your conversations. Thanks.

Can you draft a quick thank you from Gov - send to jan and we will print/send to Jim Rogan.

Kathleen

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@aso.org]
Sent: Friday, July 12, 2002 10:32 AM
To: Kathleen Shanahan (E-mail)
Cc: Melissa Freedman (E-mail); Governor Bush (E-mail)
Subject: letter from Rogan

Kathleen, we rec'd your fax re--Barcardi response from Rogan. Can we share it w/ Jorge Rodriguez, Barcardi?

The letter essentially tells us what Melissa and I have said all along....Jorge's lawyers are pursuing the wrong strategy. Rogan can't do a thing because Barcardi has now sued the P&T office. Rogan now needs to wait for a court decision.

Nina.

Muniz, Carlos

From: Shanahan, Kathleen [Kathleen.Shanahan@MyFlorida.com]
Sent: Friday, July 12, 2002 4:53 PM
To: Oviedo, Nina; Shanahan, Kathleen
Cc: Governor Bush (E-mail); Russo, Jan; Freedman, Melissa; Canady, Charles T.
Subject: RE: letter from Rogan

perfect
let; get gov to sign on monday when back
thanks all
kathleen

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Friday, July 12, 2002 2:30 PM
To: Kathleen Shanahan (E-mail)
Cc: Governor Bush (E-mail); Jan Russo (E-mail); Melissa Freedman
(E-mail); Charles Canady (E-mail)
Subject: FW: letter from Rogan

Kathleen, see Melissa's draft note from Gov to Rogan. Jon Dudas is a former Charles Canady staffer....has been very helpful to us on this issue. Nina.

Jan---pls format. Thanks.

Charles----fyi----your former staff's good efforts! Nina

-----Original Message-----

From: Melissa Freedman [mailto:freedmm@sso.org]
Sent: Friday, July 12, 2002 2:20 PM
To: Nina Oviedo
Subject: FW: letter from Rogan

Jim,

Thank you for the information you passed along regarding the Bacardi case. Your candor on the issue is appreciated. Along with the continued assistance of Mr. Jon Dudas, your attention to this matter has been very helpful. Please do not hesitate to call upon me, if I can be of service to you in the future.

Sincerely,

Jeb Bush

(Suggestion: Handwrite a hello from Kathleen and Charles.)

-----Original Message-----

From: Shanahan, Kathleen [mailto:Kathleen.Shanahan@MyFlorida.com]
Sent: Friday, July 12, 2002 1:26 PM
To: Oviedo, Nina; Shanahan, Kathleen
Cc: Freedman, Melissa; Governor Bush (E-mail)
Subject: RE: letter from Rogan

I wanted to be sure of the facts that is what I read in ltr as well. You all should send the ltr to Jorge as a follow on to your conversations. Thanks.

Can you draft a quick thank you from Gov - send to jan and we will

print/send to Jim Rogan.

Kathleen

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]

Sent: Friday, July 12, 2002 10:32 AM

To: Kathleen Shanahan (E-mail)

Cc: Melissa Freedman (E-mail); Governor Bush (E-mail)

Subject: letter from Rogan

Kathleen, we rec'd your fax re--Barcardi response from Rogan. Can we share it w/ Jorge Rodriguez, Barcardi?

The letter essentially tells us what Melissa and I have said all along....Jorge's lawyers are pursuing the wrong strategy. Rogan can't do a thing because Barcardi has now sued the P&T office. Rogan now needs to wait for a court decision.

Nina.

Muniz, Carlos

From: Lauren Burke [burkel@sso.org]
Sent: Monday, July 15, 2002 1:20 PM
To: Oviedo, Nina
Subject: FW: letter from Rogan

-----Original Message-----

From: Lauren Burke [mailto:burkel@sso.org]
Sent: Monday, July 15, 2002 1:19 PM
To: Russo, Jan
Subject: RE: letter from Rogan

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

-----Original Message-----

From: Russo, Jan [mailto:Jan.Russo@MyFlorida.com]
Sent: Monday, July 15, 2002 1:04 PM
To: Burke, Lauren
Subject: FW: letter from Rogan

-----Original Message-----

From: Russo, Jan
Sent: Friday, July 12, 2002 2:46 PM
To: Oviedo, Nina
Subject: RE: letter from Rogan

happy to format: may I please get a last name and address for the letter?

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@sso.org]
Sent: Friday, July 12, 2002 2:30 PM
To: Kathleen Shanahan (E-mail)
Cc: Governor Bush (E-mail); Jan Russo (E-mail); Melissa Freedman (E-mail); Charles Canady (E-mail)
Subject: FW: letter from Rogan

Kathleen, see Melissa's draft note from Gov to Rogan. Jon Dudas is a former Charles Canady staffer....has been very helpful to us on this issue. Nina.

Jan----pls format. Thanks.

Charles----fyi----your former staff's good efforts! Nina

-----Original Message-----

From: Melissa Freedman [mailto:freedmm@sso.org]
Sent: Friday, July 12, 2002 2:20 PM
To: Nina Oviedo
Subject: FW: letter from Rogan

Jim,

FOIA 0098

Thank you for the information you passed along regarding the Bacardi case. Your candor on the issue is appreciated. Along with the continued assistance of Mr. Jon Dudas, your attention to this matter has been very helpful. Please do not hesitate to call upon me, if I can be of service to you in the future.

Sincerely,

Jeb Bush

(Suggestion: Handwrite a hello from Kathleen and Charles.)

-----Original Message-----

From: Shanahan, Kathleen [mailto:Kathleen.Shanahan@MyFlorida.com]
Sent: Friday, July 12, 2002 1:26 PM
To: Oviedo, Nina; Shanahan, Kathleen
Cc: Freedman, Melissa; Governor Bush (E-mail)
Subject: RE: letter from Rogan

I wanted to be sure of the facts that is what I read in ltr as well. You all should send the ltr to Jorge as a follow on to your conversations. Thanks.

Can you draft a quick thank you from Gov - send to jan and we will print/send to Jim Rogan.

Kathleen

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Friday, July 12, 2002 10:32 AM
To: Kathleen Shanahan (E-mail)
Cc: Melissa Freedman (E-mail); Governor Bush (E-mail)
Subject: letter from Rogan

Kathleen, we rec'd your fax re--Barcardi response from Rogan. Can we share it w/ Jorge Rodriguez, Barcardi?

The letter essentially tells us what Melissa and I have said all along....Jorge's lawyers are pursuing the wrong strategy. Rogan can't do a thing because Barcardi has now sued the PET office. Rogan now needs to wait for a court decision.

Nina.

Muniz, Carlos

From: Melissa Freedman [freedmm@ssso.org]
Sent: Wednesday, July 17, 2002 1:48 PM
To: Oviedo, Nina; Russo, Jan
Subject: RE: letter from Rogan

Sure--you can send it to:

Undersecretary and Director James Rogan
US Patent and Trademark Office
Crystal Park, Building 2
2121 Crystal Drive
Arlington, VA 22202

Thanks, Melissa

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Wednesday, July 17, 2002 1:14 PM
To: Melissa Freedman (E-mail); Jan Russo (E-mail)
Subject: FW: letter from Rogan

Jan, as you know...I've been out of town.

Melissa---can you help her out? Nina

-----Original Message-----

From: Russo, Jan [mailto:Jan.Russo@MyFlorida.com]
Sent: Friday, July 12, 2002 2:46 PM
To: Oviedo, Nina
Subject: RE: letter from Rogan

happy to format: may I please get a last name and address for the letter?

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Friday, July 12, 2002 2:30 PM
To: Kathleen Shanahan (E-mail)
Cc: Governor Bush (E-mail); Jan Russo (E-mail); Melissa Freedman (E-mail); Charles Canady (E-mail)
Subject: FW: letter from Rogan

Kathleen, see Melissa's draft note from Gov to Rogan. Jon Dudas is a former Charles Canady staffer....has been very helpful to us on this issue. Nina.

Jan----pls format. Thanks.

Charles----fyi----your former staff's good efforts! Nina

-----Original Message-----

From: Melissa Freedman [mailto:freedmm@ssso.org]
Sent: Friday, July 12, 2002 2:20 PM
To: Nina Oviedo
Subject: FW: letter from Rogan

Jim,

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please do not hesitate to call upon me, if I can be of service to you in the future.

Sincerely,

Jeb Bush

(Suggestion: Handwrite a hello from Kathleen and Charles.)

-----Original Message-----

From: Shanahan, Kathleen [mailto:Kathleen.Shanahan@MyFlorida.com]
Sent: Friday, July 12, 2002 1:26 PM
To: Oviedo, Nina; Shanahan, Kathleen
Cc: Freedman, Melissa; Governor Bush (E-mail)
Subject: RE: letter from Rogan

I wanted to be sure of the facts that is what I read in ltr as well.
You all should send the ltr to Jorge as a follow on to your conversations.
Thanks.

Can you draft a quick thank you from Gov - send to jan and we will
print/send to Jim Rogan.

Kathleen

-----Original Message-----

From: Nina Oviedo [mailto:oviedon@ssso.org]
Sent: Friday, July 12, 2002 10:32 AM
To: Kathleen Shanahan (E-mail)
Cc: Melissa Freedman (E-mail); Governor Bush (E-mail)
Subject: letter from Rogan

Kathleen, we rec'd your fax re--Barcardi response from Rogan. Can we share
it w/ Jorge Rodriguez, Barcardi?

The letter essentially tells us what Melissa and I have said all
along....Jorge's lawyers are pursuing the wrong strategy. Rogan can't do a
thing because Barcardi has now sued the PsT office. Rogan now needs to wait
for a court decision.

Nina.

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]
Sent: Wednesday, May 22, 2002 10:47 AM
To: Oviedo, Nina
Subject: Bacardi letter finished



bacardi_letter.doc

Nina,

Here is the edited version of our Bacardi letter.

I can bring in your last edits to see where I made changes, if you'd like.

Thanks, Melissa

FOIA 0102

May 22, 2002

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Under Secretary Rogan:

I am writing on behalf of Florida-based Bacardi-Martini, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini, Inc. generates close to one billion dollars worth of business a year nationally. The company's domestic headquarters are located in Coral Gables and represents more than 300 jobs to Florida and more than 600 people throughout the US.

As I understand, since 1997 Bacardi-Martini, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration to the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family that owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. Years later, the company Havana Club Holdings, jointly owned by CubaExport and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, Bacardi-Martini, Inc. purchased the Havana Club brand and assets in 1997 from the original owners.

Though Bacardi-Martini, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.

A swift resolution to this matter is imperative. Should you have further questions, please do not hesitate to contact my Washington DC Office at 202/624-5885. Thank you for your consideration of this matter.

Sincerely,

Jeb Bush
Governor

FOIA 0103

Muniz, Carlos

From: Melissa Freedman [freedmm@sso.org]
Sent: Wednesday, May 22, 2002 1:06 PM
To: Oviedo, Nina
Subject: Bacardi Letter



bacardi_letter.doc

Hi Nina,

Finally...we got all of our questions answered by Jorge at Bacardi. Here is the final version of the letter.

Thanks, Melissa

May 22, 2002

The Honorable James E. Rogan
US Patent and Trademark Office
Crystal Park, Building 2, Room 906
2121 Crystal Drive
Arlington, VA 22202

Dear Under Secretary Rogan:

I am writing on behalf of Florida-based Bacardi-Martini, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

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As I understand, since 1997 Bacardi-Martini, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration to the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family that owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by CubaExport and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini, Inc. purchased the Havana Club brand and assets in 1997 from the original owners.

Though Bacardi-Martini, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.

A swift resolution to this matter is imperative. Should you have further questions, please do not hesitate to contact my office. You may also feel free to contact my Washington DC Office at 202/624-5885. Thank you for your consideration of this matter.

Sincerely,

Jeb Bush
Governor

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Thursday, May 23, 2002 9:36 AM
To: Freedman, Melissa
Cc: Oviedo, Nina
Subject: Re: Letter to PTO--URGENT

Importance: High



Jeb-PTO-5-23-02.d letter_PTO_jorge.d
oc oc



Dear Melissa,

I just got your e-mail this morning as I was in DC all day yesterday. Here attached is your own draft but showing now in red some minor changes I have made.

I changed Bacardi's name to reflect the name which must be shown in PTO's records because it was the name when this problem started.

Also, my office is in Coral Gables but Bacardi USA's office is in the City of Miami. I am the president of Bacardi-Martini Inc which is a service company to Bacardi globally.

CubaExport's name is now AGAIN showing in the PTO's registration for Havana Club because when in January 15th of this year PTO acted to follow the Federal Court's mandate to remove Havana Club Holdings from the registration, PTO decided then to leave the registration in the name of CubaExport who had the registration before HCH.

Bacardi's complaint is that CubaExport HAS NO LONGER ANY RIGHTS AT ALL because they gave up their "alleged" rights to HCH's in 1993 who lost them in Federal Court in 1997. However, Bacardi holds the ONLY pending application for that registration at PTO since we filed it in 1995.

Remember, that once Larson from State Department approves the denial of the Pernod-Cuba pending application at OFAC, the PTO issue could become a lot easier to be resolved, therefore, do not forget the need to have that OFAC license denied.

Thank you for your help.
Jorge

(See attached file: Jeb-PTO-5-23-02.doc)

"Melissa
Freedman"
marquez@bacardi.com>
<freedmm@ssso.
org>

To: "J Rodriguez-Marquez" <jrodriguez-
cc: "Nina Oviedo" <oviedon@ssso.org>
Subject: Letter to PTO--URGENT

05/22/2002

02:38 PM
Please
respond to
freedmm

Hi Jorge,

I hope all is well...though I know our issue with Cuba is still pending.

On that matter, I have attached the letter that we would like to send to the Governor today for his signature. However, I wanted to offer you a chance to review it to be sure that my facts are correct. The ownership/registration is such a long story, I want to be sure I have names, dates, etc. correct.

Please get back to me as soon as you can, as I am going out of town this evening, but want to take care of this before I go.

Thanks so much--I look forward to hearing from you.
Melissa

(See attached file: letter_PTO_jorge.doc)

Dear :

I am writing on behalf of Florida-based Bacardi-Martini, USA, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini USA, Inc. generates close to one billion dollars worth of business a year nationally. The company's domestic headquarters are located in Miami and has a workforce of more than 300 Floridians and over 600 employees throughout the US.

As I understand, since 1997 Bacardi-Martini USA, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration to the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family that owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by Castro's Cuban government and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini USA, Inc. purchased the Havana Club brand and assets in 1995 from the original owners.

Though Bacardi-Martini USA, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.

A swift resolution to this matter is imperative. Should you have further questions, please do not hesitate to contact my office. You may also feel free to contact my Washington DC Office at 202/624-5885. Thank you for your consideration of this matter.

Dear :

I am writing on behalf of Florida-based Bacardi-Martini, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately.

Bacardi-Martini, Inc. generates close to one billion dollars worth of business a year nationally. The company's domestic headquarters are located in Coral Gables and has a workforce of more than 300 Floridians and over 600 employees throughout the US.

As I understand, since 1997 Bacardi-Martini, Inc. has sought, through every legal channel, to cancel the Fidel Castro regime's registration to the Havana Club trademark. In 1960, Fidel Castro confiscated the Havana Club brand from the family that owned the company. Castro transferred the brand name to CubaExport, a Cuban government-controlled company in 1976. In 1993, the company Havana Club Holdings, jointly owned by CubaExport and the French company Pernod-Ricard, applied for and was granted, legal registration of the brand for use in the United States. However, it was not theirs to register. Furthermore, Bacardi-Martini, Inc. purchased the Havana Club brand and assets in 1997 from the original owners..

Though Bacardi-Martini, Inc. has spent a great deal of time and money to cancel the delinquent registration owned by the Castro regime, there has been no relief for the company. Instead, they have been faced with a process mired in lengthy bureaucratic procedures, with no end in sight.

A swift resolution to this matter is imperative. Should you have further questions, please do not hesitate to contact my office. You may also feel free to contact my Washington DC Office at 202/624-5885. Thank you for your consideration of this matter.

Muniz, Carlos

From: J Rodriguez-Marquez [jrodriguez-marquez@bacardi.com]
Sent: Tuesday, August 27, 2002 4:17 PM
To: Oviedo, Nina; Freedman, Melissa
Subject: Update on OFAC and PTO-- Bacardi's Case

Importance: High



plc29358.pcx



plc26962.pcx

Dear Nina and Melisea,
Below is my message to you of 08-08-02 in case you missed it..
(Note: My grammatical construction is usually bad but the one way below...
sorry, it is very bad !)

OFAC UPDATE:
Unfortunately, Alan Larson (Under Sectary. State) decided to miss his best
opportunity to send his letter to OFAC recommending the denial of the
pending license which Castro/Pernod have been waiting for since 1997.

Two weeks ago, Friday August 9th would have been the best time for Larson
to act because it was a Friday (no news on Saturday), in August (most
people out of DC) and he was going on vacation for two weeks. Instead he
asked his Chief of Staff to call me and tell me that he had not acted on
the letter but that he would call me after his return Monday August 26. I
have not heard from him at all.

I am now proceeding under the assumption that Alan Larson is not a help but
an obstacle and major problem.
His predecessor Stewart Eizenstat created in 1997 this new OFAC license
application as a gift to the French (Pernod) and now Larson is continuing
that same Clinton administration policy. It should not be surprising to me
that Larson does NOT act as Bush doctrine follower.

This issue has been preventing Bacardi from creating new business and
Larson continues to ignore the damage he is costing our company.

Anything you can do to have this illegal pending application denied will be
greatly beneficial for Bacardi's business.

Let me know what you think we can do next.

Regards,
Jorge

----- Forwarded by J Rodriguez-Marquez/SMUSA/Bacardi on 08/27/2002 12:07 PM

J
Rodriguez-Mar
quez

To: freedmm@sso.org
cc: oviedon@sso.org
Subject: PTO and Bacardi's Case

08/08/2002
03:02 PM

FOIA 0110

(Embedded
image moved (Embedded image moved to file: pic26962.pcx)
to file:
pic29358.pcx)

Dear Melissa,

I just learned yesterday that the federal law suit which our lawyers had filed in March 19th against PTO's move of January 15th when they moved the registration of Havana Club from Havana Club Holdings (Pernod-Castro) to CubaExport (Castro's government only) has now been completed. The federal court ruled that our complaint was not valid because PTO had not made any substantive move regarding who in fact holds the registration, that was our concern that PTO was considering CubaExport as the current holder.

This means that the "cancelation procedure" which our lawyers had initiated with PTO on March 15th against CubaExport's registration can now proceed again after it was placed on-hold because of our litigation.

I hope that TTAB at PTO will now find good reasons to move FAST ENOUGH in the cancelation procedure to put a FINAL END to this Havana Club controversy.

Anything you can do at PTO's end, will be very helpful. The Governor told me recently when we were traveling back from London "I hope we can do more" after I thanked him again for his letter to Rogan.

I hear, over and over again, from sources inside State and the White House, as well as from the VP's office that the OFAC license will be denied any day and that the letter to OFAC from Larson is ready on his desk just waiting for him to sign it and send it.

Let me know what you think about PTO.

Regards,

Jorge

OFFICE OF THE UNITED STATES TRADE REPRESENTATIVE
EXECUTIVE OFFICE OF THE PRESIDENT
WASHINGTON, D.C.
20508

RECEIVED
SEP 20 2002

GOVERNOR'S LEGAL
OFFICE

USTR Press Releases are available on the USTR website at www.ustr.gov.

FOR IMMEDIATE RELEASE:
JANUARY 2, 2002

02-01
CONTACT: RICHARD MILLS
202-395-3230

WTO Issues Report Upholding Key Aspects of U.S. Law in Trademark Dispute

WASHINGTON—The World Trade Organization (WTO) issued a report today upholding key aspects of a U.S. law concerning the ownership of U.S. trademarks associated with businesses confiscated in Cuba.

Today's WTO report confirms the longstanding U.S. position that WTO intellectual property rights rules leave WTO Members free to protect trademarks by establishing their own trademark ownership criteria. The ruling does not call into question the distinction that the U.S. law in question (section 211 of the FY1999 Omnibus Appropriations Act) draws between original trademark owners and companies that acquire a trademark as part of a government confiscation.

In another key finding requested by the United States, the WTO report, issued by the Appellate Body, also overturned an earlier WTO panel report finding that section 211 denied parties fair and equitable judicial procedures to enforce trademark rights. It found, however, that the law's treatment of U.S. and Cuban companies is contrary to the national treatment and most-favored-nation obligations under WTO rules.

Today's report suggests that in the absence of discrimination a law along the lines of section 211 would be consistent with WTO rules, and therefore those trademark owners who currently enjoy protection under section 211 could continue to enjoy that protection.

At issue is a European Union (EU) challenge to a provision of U.S. law, section 211, that limits the ability of Cuban entities or their successors to claim ownership of trademarks and trade names that they have confiscated, unless the original owner has consented. The EU's complaint, claiming a violation of international trade law, specifically the Agreement on Trade-Related Intellectual Property Rights (TRIPs), was prompted in part by a dispute over a trademark for a Cuban rum.

The Appellate Body's findings cannot be appealed, and will be final when the WTO Dispute Settlement Body adopts the report. The USTR will consult closely with Congressional committees and interested Members in considering an appropriate response to today's report.

Background:

The EU requested consultations on section 211 in July 1999, and a WTO panel, composed in October 2000 to consider the EU's complaint, circulated its report on August 6, 2001. The panel found in favor of the United States on most grounds, but said that section 211 breached TRIPs Agreement obligations to make fair and equitable procedures available to right holders. The EU appealed most of the issues it lost to the WTO Appellate Body, and the United States cross-appealed on the one issue it lost. This Appellate Body report resolves those appeals.

The Appellate Body and panel reports are posted on the WTO website (www.wto.org). USTR's briefs submitted to the panel and the Appellate Body in the dispute are available at www.ustr.gov/enforcement/briefs.

###

Bacardi -
check out
briefs online.



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|----------------------|---|
| Word Mark | HAVANA CLUB |
| Goods and Services | IC 033. US 047 049. G & S: rums produced exclusively in the Province of La Havana, Cuba |
| Mark Drawing Code | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| Design Search Code | 020324 100702 260102 |
| Serial Number | 75409541 |
| Filing Date | December 22, 1997 |
| Filed ITU | FILED AS ITU |
| Owner | (APPLICANT) HAVANA CLUB HOLDING S.A. CORPORATION LUXEMBOURG 6 rue Heine L-1720 (Grand Duchy of Luxembourg) LUXEMBOURG |
| Attorney of Record | H JOHN CAMPAIGN |
| Section 44 Indicator | SECT44 |
| Priority Date | September 18, 1997 |

FOIA 0114

Prior Registrations 1031656
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAVANA"
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Type of Mark TRADEMARK
Register PRINCIPAL
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Typed Drawing

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|---------------------|--|
| Word Mark | HAVANA CLUB |
| Goods and Services | IC 033. US 047 049. G & S: rum and rum specialty drinks. FIRST USE: 19340000. FIRST USE IN COMMERCE: 19340000 |
| Mark Drawing Code | (1) TYPED DRAWING |
| Serial Number | 74572667 |
| Filing Date | September 12, 1994 |
| Filed ITU | FILED AS ITU |
| Owner | (APPLICANT) BACARDI & COMPANY LIMITED COMPANY BY MERGER LIECHTENSTEIN 1000 BACARDI ROAD NASSAU BAHAMAS |
| Assignment Recorded | ASSIGNMENT RECORDED |
| Attorney of Record | William R. Golden, Jr. |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL-2(F) |
| Live/Dead Indicator | LIVE |

| | | | | | | | | | |
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FOIA 0116



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Typed Drawing

| | | |
|----------------------|---|-----------|
| Word Mark | HAVANA CLUB | |
| Goods and Services | IC 033. US 047 049. G & S: rums produced exclusively in the Province of La Havana, Cuba | |
| Mark Drawing Code | (1) TYPED DRAWING | |
| Serial Number | 74673898 | |
| Filing Date | May 15, 1995 | |
| Owner | (APPLICANT) Havana Club Holding S.A. JOINT STOCK COMPANY LUXEMBOURG 6, rue Heine L-1720 LUXEMBOURG | |
| Attorney of Record | H JOHN CAMPAIGN | |
| Section 44 Indicator | SECT44 | |
| Prior Registrations | 1031651 | |
| Disclaimer | NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAVANA" APART FROM THE MARK AS SHOWN | |
| Type of Mark | TRADEMARK | |
| Register | PRINCIPAL | |
| Live/Dead Indicator | LIVE | FOIA 0117 |

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| PTO HOME | TRADEMARK | TESS HOME | NEW USER | STRUCTURED | FREE FORM | BROWSE DOC | BUTTON | HELP | PREV LIST |
| CURR LIST | NEXT LIST | FIRST DOC | PREV DOC | NEXT DOC | LAST DOC | | | | |

[Logout](#) Please logout when you are done to release system resources allocated for you.

[Start](#) List At: OR [Jump](#) to record: Record 32 out of 50

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



RUM HAVANA CLUB
RON HABANA CLUB
ARECHABALA

Word Mark RUM HAVANA CLUB RON HABANA CLUB ARECHABALA
 Goods and IC 033. US 047 049. G & S: distilled liquor, namely rum. FIRST USE: 19500603.
 Services FIRST USE IN COMMERCE: 19930811
 Mark Drawing (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
 Code
 Design Search 051325 260117
 Code
 Serial Number 74650678
 Filing Date March 23, 1995
 Owner (APPLICANT) Marquez-Arechabala, Gloria INDIVIDUAL UNITED STATES 3100
 Jessie Court Fairfax VIRGINIA 22030
 Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAVANA CLUB"
 and "HABANA CLUB" APART FROM THE MARK AS SHOWN
 Type of Mark TRADEMARK
 Register PRINCIPAL
 Live/Dead LIVE
 Indicator

FOIA 0118



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Wed May 15 04:31:13 EDT 2002

| | | | | | | | | | |
|-----------|-----------|-----------|----------|------------|-----------|----------|--------|------|-----------|
| PTO HOME | TRADEMARK | TESS HOME | NEW USER | STRUCTURED | FREE FORM | ADVANCED | BOTTOM | HELP | PREV LIST |
| CURR LIST | NEXT LIST | FIRST DOC | PREV DOC | NEXT DOC | LAST DOC | | | | |

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR **Jump** to record: Record 47 out of 50

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark HAVANA CLUB

Goods and Services IC 033. US 047 049. G & S: RUM

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 040125 200310 261121

Serial Number 73023981

Filing Date June 12, 1974

Registration Number 1031651

Registration Date January 27, 1976

FOIA 0119

Owner (REGISTRANT) EMPRESA CUBANA EXPORTADORA DE ALIMENTOS Y PRODUCTOS VARIOS DBA CUBA EXPORT COMPANY CUBA 55, 23RD ST. VEDADO HAVANA CUBA

(LAST LISTED OWNER) EMPRESA CUBANA EXPORTADORA DE ALIMENTOS Y PRODUCTOS VARIOS DBA CUBA EXPORT COMPANY BY

COURT ORDER CUBA 55 23RD ST. VEDADO HAVANA CUBA

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record MICHAEL KRJNSKY

Section 44 Indicator SECT44

Disclaimer APPLICANT DISCLAIMS THE WORDS "HAVANA" AND "FUDNADA EN 1878" APART FROM THE MARK AS A WHOLE.

Description of Mark THE DRAWING IS LINED FOR THE COLOR GOLD.

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 8 (6-YR).

Renewal 1ST RENEWAL 19960618

Live/Dead Indicator LIVE

| | | | | | | | | | |
|---------------------------|---------------------------|---------------------------|--------------------------|----------------------------|---------------------------|--------------------------|---------------------|----------------------|---------------------------|
| PTO HOME | TRADEMARK | TESS HOME | NEW USER | STRUCTURED | FREE FORM | SHOW DOC | TOP | HELP | PREV LIST |
| CURR LIST | NEXT LIST | FIRST DOC | PREV DOC | NEXT DOC | LAST DOC | | | | |

FOIA 0120

UNITED STATES PATENT & TRADEMARK OFFICE

OFFICE OF LEGISLATIVE AND INTERNATIONAL AFFAIRS

2121 Crystal Drive
CPK2, Suite 902
Arlington, VA 22202
(703) 305-9300 306-2960
Fax: (703) 305-8885

To: MELISSA FRIEDMAN

Date: FEBRUARY 20, 2002

Fax: 202-624-5885

Pages: 3

(including this cover sheet)

From: ELEANOR MELTZER

Subject: NOTICE TO PARTIES RE: U.S. TRADEMARK
REGISTRATION NO. 1,031,651

COMMENTS:

UNITED STATES PATENT AND TRADEMARK OFFICE

HAVANA CLUB HOLDING, S.A.)
HAVANA CLUB, INTERNATIONAL, S.A.)
Plaintiffs-Counter-Defendants-Appellants,)
vs.) NOTICE
GALLEON, S.A.,)
BACARDI-MARTINI, USA, INC.)
Defendants-Appellees.)

On October 20, 1997, the United States District Court for the Southern District of New York entered a Partial Judgment which concerns U.S. trademark registration No. 1,031,651, for the trademark "HAVANA CLUB & DESIGN" for use on rum. The Partial Judgment and accompanying opinion were certified to the Director of the United States Patent and Trademark Office pursuant to 15 U.S.C. § 1119. However, the district court ordered that the operation and enforcement of the Partial Judgment be stayed pending appeal from the final judgment in the case. On October 26, 2001, pursuant to a request from one of the parties, the United States Patent and Trademark Office (USPTO) issued an Order to Show Cause why the Director of the United States Patent and Trademark Office should not now rectify the records of the USPTO pursuant to 15 U.S.C. § 1119 to reflect the district court's order invalidating the following recorded assignments of the entire interest and goodwill in U.S. Registration No. 1,031,651 (Serial No. 73/023981):

(1) Reel: 1104 Frame: 0046

Assignor: Empresa Cubana Exportadora De Alimentos y Productos Varios,
S.A. DBA Cubaexport

Assignee: Havana Rum and Liquors, S.A.

(2) Reel: 1129 Frame: 0428

Assignor: Havana Rum and Liquors, S.A.

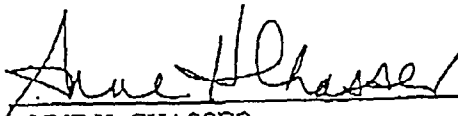
Assignee: Havana Club Holdings, S.A. DBA HCH, S.A.

Having considered the initial submissions and replies from each party and the arguments therein, the Director of the United States Patent and Trademark Office hereby gives notice that pursuant to 15 U.S.C. § 1119, the records of the USPTO will be rectified to reflect the district court's order invalidating the recorded assignments set forth above. Accordingly, the USPTO's registration records will also be rectified to conform with the assignment records.

This Notice shall be served upon:

- (1) Plaintiffs, by service upon counsel Charles S. Sims, Esq., Proskauer Rose, LLP, 1585 Broadway, New York, N.Y. 10036, and by service upon Michael Krinsky, Esq., Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., 740 Broadway, New York, N.Y. 10003; and
(2) Defendants, by service upon counsel William R. Golden, Jr., Esq., Kelley, Drye & Warren, LLP, 101 Park Avenue, New York, N.Y. 10178.

Dated: 1/15/02

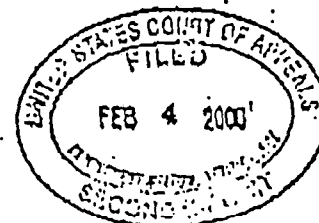

ANNE H. CHASSER
Commissioner for Trademarks

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT
UNITED STATES COURT HOUSE
40 FOLEY SQUARE
NEW YORK 10007

SDNYINMY
96-W-9655
JUDGE SCHEINDLIN

At a stated Term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City of New York, Foley Square, on the 4th day of February, two thousand.

BEFORE: Hon. Ralph K. Winter
Chief Judge
Hon. Jon O. Newman
Hon. Sonia Sotomayor
Circuit Judges



Docket No. 99-7582

HAVANA CLUB HOLDING, S.A., HAVANA CLUB INTERNATIONAL, S.A.,

Plaintiffs-Counter-Defendants-Appellants,

-v-

GALLEON S.A., BACARDI-MARTINI USA, INC.,

Defendants-Counter-Claimants-Appellees,

GALLO WINE DISTRIBUTORS, INC., G.W.D. HOLDINGS INC., PREMIER WINE AND SPIRITS,

Defendants-Appellees.

Original

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Southern District of New York and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ORDERED, ADJUDGED, and DECREED that the judgment of said district court be and it hereby is affirmed in accordance with the opinion of this court.

FOR THE COURT
Karen Greve Millon, Acting Clerk
By:

Beth J. Meador
Beth J. Meador
Administrative Attorney

Date: 7/12/01

FOIA 0124

THE MANDATE, CONSISTING OF THE
ITEMS BELOW, HAS BEEN RECEIVED.
() OFFER () STATEMENT OF COSTS
IN ORDER

RECEIVED BY _____ DATE _____

A TRUE COPY
ROSEANN B. MACKETHNIE, CLERK

Heinrich Weiss

*Aug 17, 2001
PTO CTH
[Signature]*

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



OCT 20 1997

HAVANA CLUB HOLDING, S.A. and
HAVANA CLUB INTERNATIONAL, S.A.

Plaintiffs

against

96 Civ. 9655 (SAS)

PARTIAL JUDGMENT

GALLEON S.A., DACARDI-MARTINI USA,
INC., GALLO WINE DISTRIBUTORS,
INC., G.W.D. HOLDINGS, INC.,
and PREMIER WINE AND SPIRITS

Defendants.

WHEREAS, the Plaintiffs initiated this action alleging, *inter alia*, infringement of the registered mark HAVANA CLUB for rum; and

WHEREAS, this Court issued its opinion dated August 8, 1997, in connection with certain motions therein;

NOW, THEREFORE, IT IS ORDERED, ADJUDGED AND DECREED

The Cuban Asset Control Regulations ("CACR") implemented in 1963 under Section 5(b) of the Trading With The Enemy Act of 1917, as amended, 50 U.S.C. App. 1-44, prohibit transfers of property, including trademarks, in which a Cuban entity has an interest except when authorized by the Office of Foreign Assets Control ("OFAC") acting on behalf of the Secretary of the Treasury.

2. In 1976, the trademark HAVANA CLUB for "rum" was registered in the United States Patent and Trademark Office ("related U.S. Registration") by Empresa Exportadora de Alimentos y Productos Varios ("Cubaexport"), a Cuban state enterprise.

3. On October 29, 1993, Cubaexport entered into an agreement transferring the U.S. rights to the HAVANA CLUB trademark and the related U.S. Registration to Havana Rum & Liquors, S.A. On or about November 22, 1993, Havana Rum & Liquors, S.A. entered into an agreement transferring the aforesaid mark and the related U.S. Registration to Havana Club Holding, S.A.

4. Those provisions of the original transfer agreement relating to transfers of the U.S. rights to the HAVANA CLUB mark and the related U.S. Registration were rendered null and void by the CACR, § 515.20(b)(1), and the attempted assignment of said HAVANA CLUB mark and the related U.S. Registration were invalid and of no force and effect and void *ab initio*.

5. As a result, the status quo ante as of the October 29, 1993 date of said abortive original transfer agreement is restored, and Cubaexport retained whatever rights it had in said mark and the related U.S. Registration as of said date, notwithstanding the invalid transfers.

6. Neither Havana Rum & Liquors, S.A., Havana Club Holding, S.A. nor its licensee, Havana Club International, S.A., ever obtained any rights to the HAVANA CLUB mark in the United States by transfer.

7. Plaintiffs Havana Club Holding, S.A. and Havana Club International, S.A., have no rights to the registered trademark HAVANA CLUB for "rum" in the United States.

8. Any rights that Havana Club Holding, S.A. may have had, may have or claims to have had in the Registration of the HAVANA CLUB trademark (U.S. Reg. No. 1,031,651) from

forever until today are hereby canceled.

9. Count I for infringement of a federally registered trademark under Section 32 of the Lanham Act is dismissed with prejudice.

10. Nothing herein shall prevent Cubaexport, if it so chooses, from asserting or seeking to enforce rights in the trademark HAVANA CLUB rum in the United States and nothing herein shall prevent the defendants or others from contesting those rights or contending that said rights were lost as a result of acts or omissions by Cubaexport.

11. The Court certifies the instant Order and its Opinion and Order dated August 8, 1997 to the Commissioner of Patents and Trademarks pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119.

12. The operation and enforcement of this Judgment, including modification of or entry upon the records of the United States Patent and Trademark Office pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, are stayed pending appeal from the final judgment in this action.

Dated at New York, New York, this 20 day of October, 1997.


U.S.D.J.

CERTIFIED

JAMES M. PARKISON

THIS DOCUMENT WAS ENTERED
ON THE DOCKET ON 10-22-97

UNITED STATES PATENT & TRADEMARK OFFICE

OFFICE OF LEGISLATIVE AND INTERNATIONAL AFFAIRS

2121 Crystal Drive

CPK2, Suite 902

Arlington, VA 22202

(703) 305-9380 306-2960

Fax: (703) 305-8885

To: NINA OVIETA

Date: FEBRUARY 20, 2002

Fax: 202-624-5886

Pages: 5

(including this cover sheet)

From: ELEANOR MELTZER

Subject: RE: U.S. TRADEMARK REGISTRATION NO. 1,031,651

("HAWAIIAN CLUB AND DESIGN")

COMMENTS:

• 2ND CIRCUIT MANDATE

• PARTIAL JUDGMENT

APR-19-2002 15:10

EXECUTIVE OFC OF GOVERNOR

Kathleen Shanahan

From: Jeb Bush [jeb@jeb.org]
 Sent: Thursday, April 18, 2002 9:43 PM
 To: Kathleen Shanahan
 Subject: FW: BACARDI NEEDS YOUR HELP fup

this is ridiculous. let us discuss.

Jeb Bush

 Please note: Florida has a very broad public records law.
 Most written communications to or from state officials
 regarding state business are public records available to the
 public and media upon request. Your e-mail communications
 may therefore be subject to public disclosure.

-----Original Message-----

From: J Rodriguez-Marquez [mailto:jrodriguez-marquez@bacardi.com]
 Sent: Thursday, April 18, 2002 5:36 PM
 To: Jeb Bush
 Subject: BACARDI NEEDS YOUR HELP
 Importance: High

DEAR JEB,

UNFORTUNATELY NOTHING HAS CHANGED SINCE THE MEETING WITH PTO FEBRUARY 25TH.

BUREAUCRATS AT PTO CONTINUE TO WIN THE BATTLE FOR FIDEL AND PERNOD.

THIS CONFLICT IS TAKING A LIFE OF ITS OWN AND BACARDI IS BEING FORCED TO DEFEND ITS CASE PUBLICLY

IT IS EMBARRASSING TO US THAT PEOPLE, EVEN IN MIAMI, BELIEVE THAT IT IS BACARDI, NOT SOME US GOVERNMENT BUREAUCRATS, WHO ARE THE REASON FOR CASTRO AND PERNOD TO STILL CLAIM THE HAVANA CLUB BRAND.

ONCE PTO ACTS FAIRLY AND PROFESSIONALLY FOLLOWING US LAWS BACARDI'S PROBLEMS WILL BE OVER.

PLEASE. SOMEONE NEEDS TO TELL PTO TO STOP INTERFERING.

JORGE

4/20 - 2p

Nina

(are you all
 handling 2-I)

(How you
 all have

been
 working
 hard
 on this?

[Signature]

cc6w

FOIA 0129

Fax Sheet

To: Jim Rogan

Fax: (703) 305-8664

Date: July 16 , 2002

From: Carol Petty

Subject: IPO & Trade disputes w/ the EU & Canada.

Pages (INCLUDING COVER): 6

Comments:

From: Roe, Jason
Sent: Monday, September 02, 2002 8:32 PM
To: [REDACTED]

Dudas is going to take Bacardi mtg tomorrow. We will meet you @ DoC immediately following EMT

Sent from my BlackBerry Wireless Handheld (www.BlackBerry.net)

DOCUMENT REDACTED
LAW EXEMPTION 6, FOIA
5 USC § 552(b)(6)
USPTO FOIA 02-313

FOIA 0131

From: [REDACTED]
Sent: Monday, September 02, 2002 9:47 PM
To: Jason.Roe@USPTO.GOV
Subject: RE:

Is that ok with kassenger and aldonis?

-----Original Message-----

From: Jason.Roe@USPTO.GOV [mailto:Jason.Roe@USPTO.GOV]
Sent: Monday, September 02, 2002 8:32 PM
To: [REDACTED]
Subject: [REDACTED]

Dudas is going to take Bacardi mtg tomorrow. We will meet you @ DoC immediately following EMT

Sent from my BlackBerry Wireless Handheld (www.BlackBerry.net)

DOCUMENT REDACTED
LAW EXEMPTION 6, FOIA
5 USC § 552(b)(6)
USPTO FOIA 02-313

FOIA 0132

From: Toupin, James
Sent: Wednesday, September 11, 2002 11:59 AM
To: Roe, Jason
Cc: Dudas, Jon; Rogan, James; Beresford, Lynne; Meltzer, Eleanor; Briskin, Michael
Subject: Havana Club

Jason, per our conversation, I hope this is what you're looking for by way of brief summary:

The USPTO's Trademark Trial and Appeal Board has today received a motion by respondents, in Galleon, Bacardi, et al. v. Havana Club, et al., Cancellation No. 24, 108, asking the Board to issue an order for petitioners to show cause why the proceeding should not be dismissed. The motion alleges that letters by Governor Bush of Florida to Director Rogan on behalf of petitioners (Bacardi), and communication with Deputy Director Dudas, violated the provision of the Government in the Sunshine Act under which no interested person outside an agency shall make or knowingly cause to be made to an agency, or an employee who is or may reasonably be expected to be involved in the decisional process in a proceeding, an ex parte communication on the merits. The provision requires an employee who receives such a communication to place it on the public record, and allows for a show cause order why a claim should not be dismissed as a result of such a communication. The motion asks that all proceedings in the cancellation proceeding be suspended pending decision of the motion to show cause. The motion further characterizes the temporal proximity of Governor Bush's original letter with a contribution by Bacardi to the Florida Republican Party as implicating the fairness of the proceeding. Director Rogan is, by statute, a member of the Trademark Trial and Appeal Board, but has not in his tenure participated in a proceeding of the Board, nor has he done so in this case.

From: Roe, Jason
Sent: Wednesday, September 11, 2002 1:54 PM
To: Prostin, Elizabeth
Cc: Dudas, Jon; Meltzer, Eleanor
Subject: FW: Havana Club

E-

They did file a motion w/ the Trademark Trial and Appeal Board. A brief summary below.

Jason

-----Original Message-----

From: Toupin, James
Sent: Wednesday, September 11, 2002 11:59 AM
To: Roe, Jason
Cc: Dudas, Jon; Rogan, James; Beresford, Lynne; Meltzer, Eleanor; Brislin, Michael
Subject: Havana Club

Jason, per our conversation, I hope this is what you're looking for by way of brief summary:

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St.....
To:
Subject:

Wednesday, September 11, 2002 1:54 PM
Toupin, James
RE: Havana Club

thanks jim

-----Original Message-----

From: Toupin, James
Sent: Wednesday, September 11, 2002 11:59 AM
To: Roe, Jason
Cc: Dudas, Jon; Rogan, James; Beresford, Lynne; Melzer, Eleanor; Briskin, Michael
Subject: Havana Club

Jason, per our conversation, I hope this is what you're looking for by way of brief summary:

The USPTO's Trademark Trial and Appeal Board has today received a motion by respondents, in Galleon, Bacardi, et al. v. Havana Club, et al., Cancellation No. 24, 108, asking the Board to issue an order for petitioners to show cause why the proceeding should not be dismissed. The motion alleges that letters by Governor Bush of Florida to Director Rogan on behalf of petitioners (Bacardi), and communication with Deputy Director Dudas, violated the provision of the Government in the Sunshine Act under which no interested person outside an agency shall make or knowingly cause to be made to an agency, or an employee who is or may reasonably be expected to be involved in the decisional process in a proceeding, an ex parte communication on the merits. The provision requires an employee who receives such a communication to place it on the public record, and allows for a show cause order why a claim should not be dismissed as a result of such a communication. The motion asks that all proceedings in the cancellation proceeding be suspended pending decision of the motion to show cause. The motion further characterizes the temporal proximity of Governor Bush's original letter with a contribution by Bacardi to the Florida Republican Party as implicating the fairness of the proceeding. Director Rogan is, by statute, a member of the Trademark Trial and Appeal Board, but has not in his tenure participated in a proceeding of the Board, nor has he done so in this case.

SL....
To:
Subject:

Wednesday, September 11, 2002 9:47 PM
Roe, Jason
RE:

Jason -

I'll provide you with what we have. If you believe more detail is necessary/desirable, please let me know.

Eleanor
(703) 306-2960

—Original Message—

From: Roe, Jason
Sent: Wednesday, September 11, 2002 4:56 PM
To: Meltzer, Eleanor
Subject:
Importance: High

do we have any briefs on the bacardi issue or can one be drafted for background for eliz. prostic at DoC?

Jason C. Roe, Chief of Staff
Office of the Under Secretary of Commerce for Intellectual Property
2121 Crystal Drive, Suite 906 | Arlington, VA 22202
Phone (703)305-8600 | Fax (703)305-8664
<mailto:jason.roe@uspto.gov> | www.uspto.gov

From: Roe, Jason
Sent: Sunday, September 01, 2002 3:18 PM
To: Dudas, Jon
Subject: Bacardi

DOCUMENT REDACTED
1AW EXEMPTION 6, FOIA
5 USC § 552(b)(6)
USPTO FOIA 02-313

Need to talk w/ you today about Bacardi.

Call me at the office until 400

@ home later [REDACTED]

Jason C. Roe, Chief of Staff
Office of the Under Secretary of Commerce for Intellectual Property
2121 Crystal Drive, Suite 906 | Arlington, VA 22202
Phone (703)305-8600 | Fax (703)305-8664
mailto:jason.roe@uspto.gov | www.uspto.gov

Dudas, Jon

From: Dudas, Jon
Sent: Tuesday, September 17, 2002 10:52 AM
To: Meltzer, Eleanor
Subject: FW:
Importance: High
Sensitivity: Confidential
Follow Up Flag: Follow up
Flag Status: Flagged

Should you want it for your records

-----Original Message-----

From: Christine.Kojac@mail.house.gov [mailto:Christine.Kojac@mail.house.gov]
Sent: Monday, September 16, 2002 4:35 PM
To: jon.dudas@uspto.gov
Subject:
Importance: High
Sensitivity: Confidential

Jon,

- 1.) The Chairman is very concerned about the proposed RIF's in trademarks. How much will the proposed RIF's cost? Is there ANYthing we can do to stop this from happening?
- 2.) I need to have a response back from you that the work @ home program is back on track. I know Chris has talked to me about it, but it is still not back on track. This and the RIF's is a real concern for the Chairman.
- 3.) On a lighter note, I have requested an up to date report from Clarence Crawford on the fee collections to date and the amount of fees you all have collected Patents and trademarks and the amounts you are unable to spend. I asked for this as soon as possible. It would be helpful to have it this evening.
- 4.) Can you give me PTO's response to the Washington Post article re: Bacardi?

Thank you.

Please give me a call when you are able to do s

FOIA 0138

Dudas, Jon

From: Dudas, Jon
Sent: Tuesday, September 17, 2002 10:46 AM
To: Meltzer, Eleanor
Subject: RE: Answer to Christine's Bacardi Question

Nicely done. I do not want to e-mail anything. I did let you and Chris know what I said. Would you please let Richard/Brigid know? Thanks, Jon
By the way, should we set up the office over here for you--or would that have a negative repercussion (2 offices)?

-----Original Message-----

From: Meltzer, Eleanor
Sent: Monday, September 16, 2002 9:31 PM
To: Dudas, Jon
Subject: Answer to Christine's Bacardi Question

1.) The Chairman is very concerned about the proposed RIF's in trademarks. How much will the proposed RIF's cost? Is there ANYthing we can do to stop this from happening?

Jon - May I ask you a couple of questions about this?

2.) I need to have a response back from you that the work @ home program is back on track. I know Chris has talked to me about it, but it is still not back on track. This and the RIF's is a real concern for the Chairman.

3.) On a lighter note, I have requested an up to date report from Clarence Crawford on the fee collections to date and the amount of fees you all have collected Patents and trademarks and the amounts you are unable to spend. I asked for this as soon as possible. It would be helpful to have it this evening.

4.) Can you give me PTO's response to the Washington Post article re: Bacardi?

Proposed Answer -

- The Office routinely receives - and responds to - inquiries on pending applications and proceedings. Inquiries on pending applications and proceedings, particularly from elected officials writing on behalf of their constituents, are so common that we have at least one employee <Janie Cooksey> who has full-time responsibility for drafting responses.
- Regarding this specific case, both parties have a history of promoting their views through the press. The USPTO is merely a victim of circumstance - the cancellation proceeding happens to be pending before our agency - so we are resigned to being mentioned, periodically, as the parties air their differences to the media.
- Trademark files are all open to the public, so anyone with interest can read the letter from our Office to Governor Bush, which we are faxing to you. Bottom line for us: the *Washington Post* article was par for the course with respect to this case.

[Jon - If you send this or say it, you should let Chris/Richard/Brigid know what you've said.]

FOIA 0139

Dudas, Jon

From: Christine.Kojac@mail.house.gov
Sent: Monday, September 16, 2002 4:35 PM
To: jon.dudas@uspto.gov

Importance: High
Sensitivity: Confidential

Jon,

- 1.) The Chairman is very concerned about the proposed RIF's in trademarks. How much will the proposed RIF's cost? Is there ANYthing we can do to stop this from happening?
- 2.) I need to have a response back from you that the work @ home program is back on track. I know Chris has talked to me about it, but it is still not back on track. This and the RIF's is a real concern for the Chairman.
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- 4.) Can you give me PTO's response to the Washington Post article re: Bacardi?

Thank you.

Please give me a call when you are able to do so

Dudas, Jon

From: Boland, Lois
Sent: Thursday, August 22, 2002 8:23 AM
To: Dudas, Jon
Cc: Lo, Jennifer; Meltzer, Eleanor
Subject: FW: "HAVANA CLUB" Update

Importance: High

Per your request ...

-----Original Message-----

From: Meltzer, Eleanor
Sent: Thursday, August 22, 2002 8:10 AM
To: Boland, Lois
Subject: "HAVANA CLUB" Update
Importance: High

FOIA 0140

Lois -

Yesterday afternoon, Jon requested that I provide him with an update on the "HAVANA CLUB" proceedings in anticipation of a September 3rd meeting with Grant Aldonas to discuss the possible implications of a recent State Department decision memo regarding transfer of the "HAVANA CLUB" mark.

Pursuant to the guidance we recently received, rather than send this information directly to Jon, I am providing it to you.



EXECUTIVE OFFICE OF THE GOVERNOR
STATE OF FLORIDA

Eleanor,
I want to thank you and Jon for
taking the time to meet with Jorge
Rodriguez, Elizabeth Cladarola and
myself. Your time and efforts are
greatly appreciated.
Please let me know if there is anything
I can do for you or your office. -Melissa



MELISSA FREEDMAN
LEGISLATIVE ANALYST
OFFICE OF GOVERNOR JEB BUSH

STATE OF FLORIDA
444 NORTH CAPITOL STREET
SUITE 349
WASHINGTON, D.C. 20001

TELEPHONE: (202) 624-5885
FAX: (202) 624-5886
E-MAIL: freedmm@siso.org
WEBSITE: www.MyFlorida.com

Fawcett, Robert D.

From: Knight, Bernard
Sent: Thursday, October 17, 2002 6:55 PM
To: Briskin, Michael; Fawcett, Robert D.
Subject: FW: Bacardi issue

Follow Up Flag: Follow up
Flag Status: Flagged

An email that Jon Dudas had.

-----Original Message-----

From: Dudas, Jon
Sent: Thursday, October 17, 2002 5:43 PM
To: Knight, Bernard
Subject: FW: Bacardi issue

-----Original Message-----

From: Meltzer, Eleanor
Sent: Monday, June 17, 2002 12:16 PM
To: Dudas, Jon; 'Jon.dudas@att.net'
Subject: RE: Bacardi issue



DRAFT - Havana
Club - Gov Budh...

Jon -

I've taken a just-the-facts approach in this draft.

In order to avoid the "@#\$\$%&*! obstructionist bureaucrat" moniker, perhaps it would be best to provide a response as soon as possible, even if it is destined to be laminated, framed, and given a prominent position at next week's meeting. In addition, it might be a good thing to run this up the Main Commerce flagpole before sending it on its way.

Next time you see me in the hallway, let's talk about **WINNING LOTTERY NUMBERS!!!**

Eleanor
(703) 306-2960

-----Original Message-----

From: Lo, Jennifer
Sent: Friday, June 14, 2002 5:57 PM
To: Dudas, Jon; Meltzer, Eleanor; 'Jon.dudas@att.net'
Subject: Bacardi Issue

Here's the text from the letter...

<< File: I am writing on behalf of Florida.doc >>

Eleanor- I made a copy for you and slipped it under your door.

FOIA 0142

Thanks,

Jennifer Lo

*Office of the Deputy Under Secretary
and Deputy Director of USPTO
(703) 305-8700*

FOIA 0143

The Honorable Jeb Bush
Office of the Governor
The Capitol
Tallahassee, Florida 32399-0001

Dear Governor Bush:

This is in response to your correspondence of June 13, 2002, regarding the trademark "HAVANA CLUB." You have requested that the United States Patent and Trademark Office (USPTO) cancel this registration immediately.

U.S. Trademark Registration No. 1,031,651 ("HAVANA CLUB" and design) is the subject of Cancellation Proceeding No. 92-024108 before the USPTO's Trademark Trial and Appeal Board (TTAB).

The cancellation proceeding was initiated in 1995 by Galleon S.A., Bacardi-Martini U.S.A., Inc., and Bacardi & Company Ltd. ("Bacardi"), against Havana Club Holding, S.A and Havana Rum & Liquors, S.A., d/b/a/ H.R.L., S.A. ("HCH"). At the request of the parties, the proceeding was suspended on July 1, 1999, pending the outcome of other civil litigation. The proceeding was revived, again at the request of the parties, earlier this year.

On March 15, 2002, Bacardi filed a petition to substitute CubaExport as the defendant in the cancellation proceeding and to obtain summary judgment (for cancellation). On March 19, 2002, Bacardi filed with the U.S. Court of Appeals for the Federal Circuit a petition for review of the Commissioner for Trademark's January 15, 2002 order. *Galleon, S.A. v. Chasser*, No. 02-1289 (Fed. Cir.).¹ On May 13, 2002, the TTAB suspended action on the cancellation proceeding pending the outcome of the relevant litigation (*Galleon, S.A. v. Chasser*, No. 02-1289) in the U.S. Court of Appeals for the Federal Circuit.

To an important degree, the parties themselves are determining the pace of final resolution with respect to Cancellation Proceeding No. 92-024108. Please be assured that the Office will act expeditiously when the proceeding reaches the stage where the TTAB has statutory and regulatory authority to render a final decision.

FOIA 0144

¹ On January 15, 2002, pursuant to an October 20, 1997 Court order from the United States District Court for the Southern District of New York, the USPTO's Commissioner for Trademarks ordered USPTO assignment and registration records rectified to reflect ownership of U.S. trademark Registration No. 1,031,651 in Cubaexport. The assignment changes were recorded at: Reel: 002398 Frames: 0855-0863.

Fawcett, Robert D.

From: Knight, Bernard
Sent: Thursday, October 17, 2002 6:54 PM
To: Briskin, Michael; Fawcett, Robert D.
Subject: FW: New Important Developments

Follow Up Flag: Follow up
Flag Status: Flagged



PTO-Summary
Judgment-3-15-02.D...



PTO- Key Captions
from Summary...

FYI--An email received from Dudas.

-----Original Message-----

From: Dudas, Jon
Sent: Thursday, October 17, 2002 5:43 PM
To: Knight, Bernard
Subject: FW: New Important Developments

-----Original Message-----

From: TThomas@doc.gov [mailto:TThomas@doc.gov]
Sent: Thursday, March 21, 2002 5:49 PM
To: Jon.Dudas@USPTO.GOV
Subject: New Important Developments

check this out -- just talked to Jorge

----- Forwarded by Travis Thomas/HCHB/Onet on 03/21/2002 05:48 PM -----

"J Rodriguez-Marquez"
<jrodriguez-marquez@b
acardi.com>

To: tthomas@doc.gov
cc:
Subject: New Important Developments

03/20/2002 08:14 PM

Since our last conversation on the telephone Tuesday February 26th and as I mentioned to you we would, last Friday March 15th our lawyers Kelley Drye & Warren of New York filed with PTO a Motion for Cancellation of the CubaExport Registration under Summary Judgment. I am attaching here for your information the complete set of documents we filed last Friday. (See attached file: PTO-Summary Judgment-3-15-02.DOC)

Also, this next attachment gives you a short version of the filing, based on a selection I made of some of the most important issues of the filing.

(See attached file: PTO- Key Captions from Summary Judgment-3-15-02.doc)

FOIA 0145

In summary, PTO can not show CubaExport as the current holder of the Havana Club trademark because:

First.....CubaExport willingly gave up all their rights in 1993 when they transferred them to HCH.
Second.....CubaExport's 20 year registration ended in 1996 and they choose not to renew it. That is six years ago.
Third.....CubaExport was notified by US Federal Court in 1997 that HCH had just lost any and all rights to the brand and yet they still never tried to claim any rights at all.

We have had too many strange experiences with PTO during the last few years including PTO's failing to notify Bacardi as required, when the January 15th, 2002 decision was adopted; also the continued disappearances of very sensitive files from PTO records which we have been requesting for months. These complaints are all documented and acknowledged by PTO. Our latest unfortunate experience was last February 25th when I met at PTO with Jon Dudas and attorney Eleanor Meltzer and Ms Meltzer told me that "Bacardi should not have rights to the Havana Club brand because we can not make it in Havana" and before we ended the meeting she told us that "if the OFAC pending license application is granted it could change the total picture". We were all very surprised to learn that Ms Meltzer was mixing two allegations into the PTO's process which are totally independent from PTO's main concern, and also the fact that she was ready to pass judgement on two scenarios in which she has no knowledge of or jurisdiction on.

We are confident that our Motion for Summary Judgment will be dealt with expeditiously and without any undue negative influence from parties who may not agree with Bacardi's rights under the law.

Please, let me know if you have any questions. You can call me at my office 305-446-9050 or at my cell 305-613-5099.

Thank you for your time and interest in our case.

Jorge(See attached file: PTO-Summary Judgment-3-15-02.DOC) (See attached file: PTO- Key Captions from Summary Judgment-3-15-02.doc)

EXHIBIT B

CHRONOLOGY OF EVENTS¹

Persons Referenced:

| | |
|--|---|
| Lynne Beresford: | Deputy Commissioner for Trademark Examination Policy, USPTO |
| Jeb Bush: | Governor of Florida |
| Charles Canady: | General Counsel to Governor Bush |
| Jon Dudas: | U.S. Deputy Under Secretary of Commerce for Intellectual Property; Deputy Director of the USPTO |
| Melissa Freedman: | Works for Nina Oviedo |
| Elizabeth Iadarola: | Lobbyist, MWW Group (Lobbyists for Bacardi) |
| Jennifer Lo: | Employee of Jon Dudas |
| Kelley McCullough: | Associate Director of Political Affairs (White House aide to Karl Rove) |
| Eleanor Meltzer: | Attorney-Advisor, USPTO Office of Legislative and Int'l Affairs |
| Nina Oviedo: | Director, State of Florida's D.C. Office at Hall of States (SSO) |
| Jason Roc: | James Rogan's Chief of Staff |
| Jorge Rodriguez-Marquez ("Rodriguez"): | Vice-Director of Corporate Communications, Bacardi-Martini U.S.A., Inc. – Bacardi's chief in-house lobbyist |
| James Rogan: | U.S. Under Secretary of Commerce for Intellectual Property; Director of the USPTO |
| Karl Rove: | Adviser (& chief political strategist) to President George W. Bush |
| Kathleen Shanahan | Governor Bush's Chief of Staff |
| Travis Thomas: | Director, Office of Business Liaison, U.S. Dept. Of Commerce |

- 12/08/01 Jorge Rodriguez-Marquez ("Rodriguez"), Vice-Director of Corporate Communications of Bacardi-Martini U.S.A. Inc., discusses the TTAB proceeding with Kelley McCullough, aide to President George W. Bush's adviser, Karl Rove. (FOIA 0013.)
- 01/08/02 Rodriguez e-mails Governor Bush, with the subject line "BACARDI NEEDS HELP" ("1/8/02 Rodriguez e-mail"). Rodriguez asks Bush, *inter alia*, to help Bacardi in connection with its efforts in this proceeding to cancel the HAVANA CLUB trademark registration. (FOIA 0012-13.)
- 01/09/02 Governor Bush responds to Rodriguez following the 1/8/02 Rodriguez e-mail: "Jorge, I will see what I can do." (FOIA 0029.)
- 02/01/02 The 1/8/02 Rodriguez e-mail is forwarded from Governor Bush's Florida office to Nina Oviedo, who works for the Office of Governor Bush in Washington D.C. (FOIA 0012-14, 0023-24.) Handwritten notes apparently reflect a telephone conversation between Deputy Director Dudas and someone on the Governor's

¹ Underlining is used below to indicate *ex parte* communications evidenced in the available documents.

staff concerning Bacardi's efforts to cancel the HAVANA CLUB trademark registration and the view of Mr. Dudas that it "should be a slam dunk case." (FOIA 0013.)

02/06/02 E-mails indicate that Rodriguez met in Washington, D.C. with Oviedo and Oviedo's assistant, Melissa Freedman ("Freedman"), to discuss how Governor Bush could assist in Bacardi's efforts to cancel the HAVANA CLUB trademark registration. (FOIA 0020-23.)

02/07/02 Rodriguez e-mails Oviedo and Freedman and thanks them for their time at the above-mentioned 02/06/02 meeting. (FOIA 0015.) Revealing ex parte communications concerning this proceeding made by and between Bacardi and Lynne Beresford, Deputy Commissioner for Trademark Policies and Procedures at the United States Patent and Trademark Office, Rodriguez added:

"I hope I was able to make our case clear enough, but if not let me know.

UNFORTUNATELY, yesterday I gave you the wrong name about the lady from Patent and Trademark Office with whom we have been trying to work with, but without good results.

Her correct name is:

LYNNE BERESFORD

and she was, at least two months ago, Deputy Commissioner for Trademark Examination Policy."

02/20/02 Oviedo sends Rodriguez an e-mail (FOIA 0034-35) which reflects additional ex parte communications concerning this proceeding made by and between her and Freedman (on behalf of Governor Bush for Bacardi) and Eleanor Meltzer ("Meltzer"), an attorney at the U.S. Patent and Trademark Office:

"Today, Melissa [Freedman] and I spoke with a lawyer in the PTO who has followed your case (Eleanor Me[ltz]er). . . . I have asked the PTO office whether they might meet with us/you and provide some guidance.

As you know the PTO office has very serious rules and she will be checking with her supervisors to see if it is permissible."

02/20/02 Oviedo sends an e-mail to Governor Bush (FOIA 0037-38), informing the Governor of her progress with Rodriguez on the Governor's behalf, and concludes her e-mail to Governor Bush with the following reminder:

"Reminder — [Rodriguez will] be at the Florida House Luncheon. Last year Bacardi contributed over \$15K to the Florida House . . . great supporters of our Florida embassy."

- 02/25/02 Deputy Director Dudas contacts Charles T. Canady, General Counsel to Governor Bush, concerning the HAVANA CLUB trademark registration. (FOIA 0041.)
- 02/25/02 Rodriguez and Freedman meet with Deputy Director Dudas and Meltzer at the U.S. Patent and Trademark Office to discuss the Havana Club TTAB proceeding. (FOIA 0042, 0044-45, 0141, 0146.) Bacardi concludes that Meltzer may not be as helpful to its position as Dudas seemed to be, and concludes that "contact with Jon would be the most preferred method to Bacardi." (FOIA 0044.)
- 02/26/02 Rodriguez e-mails Governor Bush (FOIA 0042), revealing additional *ex parte* contacts:
"The meeting yesterday at 4:00 PM at Patent & Trademark Office (PTO) reconfirmed to us that, at least one, and most likely two female career lawyers at PTO have personal problems with our Havana Club case. One of these two lawyers was present at the meeting yesterday and in some of her answers to my complaints she incriminated herself by revealing personal negative feelings about our case. With your continued support I am sure we can have it solved soon."
- Undated Handwritten note from Freedman to Meltzer (FOIA 0141):
"Eleanor, I want to thank you and Jon [Dudas] for taking the time to meet with Jorge Rodriguez, Elizabeth Iadarola and myself. Your time and efforts are greatly appreciated. Please let me know if there is anything I can do for you or your office. — Melissa."
- 03/15/02 Bacardi files a motion to resume proceedings, to substitute CubaExport as a party-respondent, and for summary judgment canceling the HAVANA CLUB trademark registration. (FOIA 0046.)
- 03/18/02 Rodriguez informs Oviedo and Freedman of Bacardi's March 15 summary judgment filing, asks them to seek the aid of Deputy Director Dudas with respect to it, and seeks insulation from decision-makers not favorable to Bacardi:
"Would you please, help us by making sure that Patent and Trademark Office's Mr. Dudas knows that all they need to do now is be very much aware of this motion for summary judgment, so that it can go through its normal process without any undue negative 'influence' from certain parties knoww [sic.] to us." (FOIA 0046.)
- 03/18/02 Oviedo sends an e-mail to Freedman, making reference to a meeting they had with Deputy Director Dudas and Meltzer, and stating that "all indications" show that Bacardi will prevail on its motion for summary judgment:
"Jon Dudas, from PTO, called me about two weeks ago to make sure that the meeting we had with Eleanor Meltzer and himself, has

been helpful. We talked a little about the case. Now that I know Bacardi has sent in the request for cancellation of CubaExport's registration, I thought I would send Jon [Dudas] a note on our stationary, thanking him for his time on the case, and letting him know that Bacardi has made their move. Please let me know if I should go ahead with that.

(Jorge did not like some of the issues that Eleanor Meltzer brought up in our meeting, so keeping up contact with Jon [Dudas] would be the most preferred method to Bacardi, I am sure.)

Otherwise, we should do nothing for the moment. We need to wait a few weeks until PTO takes action, which from all indications will be favorable. Then its on to Commerce..." (FOIA 0044-45.)

03/19/02 Freedman contacts Deputy Director Dudas concerning Bacardi's pending motion for summary judgment, and makes reference to a series of telephonic ex parte communications concerning the proceeding:

"Hi Jon, As an FYI — I wanted to let you know that our office heard from Mr. Jorge Rodriguez Marquez, President of Bacardi, yesterday. He informed us that Bacardi filed a motion for cancellation of the CubaExport registration on summary judgment with the Patent and Trademark Office last Friday, March 15th. If we can help this matter in any way, please let me know. Thanks so much for your time and follow-up calls. It is appreciated." (FOIA 0069.)

03/21/02 Rodriguez emails Travis Thomas, Director at the U.S. Department of Commerce ("Thomas"):

"Our latest unfortunate experience was last February 25th when I met at PTO with Jon Dudas and attorney Eleanor Meltzer and Ms. Meltzer told me that 'Bacardi should not have rights to the Havana Club brand because we can not make it in Havana'

"We are confident that our Motion for Summary Judgment will be dealt with expeditiously and without any undue negative influence from parties who may not agree with Bacardi's rights under the law." (FOIA 0146.)

Thomas then forwards this e-mail to Deputy Director Dudas. (FOIA 0145.)

03/22/02 Freedman informs Rodriguez that she contacted Deputy Director Dudas to let him know of Bacardi's summary judgment motion:

"We have made the contact already, and will now await their response to your filing." (FOIA 0073.)

- 04/09/02 Freedman sends an e-mail to Oviedo, and Oviedo forwards it to Governor Bush and others: "Rodriguez is requesting our help to put pressure on these two bureaucracies [the PTO and OFAC], where possible." (FOIA 0070.)
- 04/18/02 Rodriguez complains Governor Bush that "NOTHING HAS CHANGED SINCE THE MEETING WITH PTO FEBRUARY 25TH. . . . PLEASE, SOMEONE NEEDS TO TELL PTO TO STOP INTERFERING." (FOIA 0075.)
- 04/23/02 Freedman explains to Oviedo that "[a]t a meeting that Bacardi and our office attended, with representatives from the Patent Office, Bacardi was told that in order to obtain their license and registration for Havanna [sic.] Club Holdings, Bacardi would have to request that the Patent Office expunge CubaExport/Pernod's registration of the company." (FOIA 0077.)

Oviedo then forwards the e-mail to Governor Bush and others, noting:

"Former Congressman Jim Rogan (R-CA) was recently confirmed by the Senate as the Undersecretary for Intellectual Property and Director of the Patent Office. Melissa [Freedman] and Jorge [Rodriguez] previously met with the Deputy Undersecretary and Deputy Director. After another meeting, we might need to come back to you for an additional push." (FOIA 0076.)

- 04/24/02 Oviedo sends the following e-mail to Governor Bush and others:

"Melissa [Freedman] is setting up another set of meetings with the Patent Office and State Dept. After those meetings we may need you to personally chime in. Melissa spoke with Jorge [Rodriguez] yesterday Jorge will make his schedule available to us at any time. After those meetings we'll adjust the strategy as necessary. We'll follow-up after meetings. Nina." (FOIA 0076.)

- 04/26/02 Kathleen Shanahan, Governor Bush's Chief of Staff, advises Governor Bush and Oviedo that "we may need to move up the food chain." (FOIA 0078.)
- 06/13/02 Governor Bush writes to James E. Rogan, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("Rogan"):

I am writing on behalf of Florida-based Bacardi-Martini USA, Inc. to ask that the Patent and Trademark Office take quick, decisive action on a pending application to expunge the registration of the trademark Havana Club. The out-dated registration belongs to a company owned by Fidel Castro called CubaExport and should be cancelled immediately." (FOIA 0001(emphasis added).)

06/14/02 Jennifer Lo, an employee at the Office of the Deputy Under Secretary and Deputy Director of the PTO, forwards to Deputy Director Dudas and Meltzer a copy of Governor Bush's June 13, 2002 letter. (FOIA 0142.)

06/17/02 Meltzer provides to Deputy Director Dudas a draft letter to be sent to Governor Bush in response to Governor Bush's June 13, 2002 letter to Director Rogan. Meltzer's draft accurately recites that

"You have requested that the United States Patent and Trademark Office (USPTO) cancel this registration immediately." (FOIA 0144.)

The reference to the call for cancellation was deleted in the drafting process and does not appear in the final version from Director Rogan to Governor Bush, dated July 3, 2002. (FOIA 0002.)

07/03/02 Director Rogan responds to Governor Bush concerning the proceeding, promising, *inter alia*, that the PTO "will act expeditiously when the proceeding reaches the stage where the TTAB has statutory and regulatory authority to render a final decision." (FOIA 0002-03.)

07/16/02 Governor Bush sends a letter to Director Rogan, thanking him for his "attention to this matter" and expressing his appreciation for the "continued assistance of Mr. Jon Dudas," which he characterizes as "very helpful." (FOIA 0011.)

07/31/02 U.S. Court of Appeals for the Federal Circuit dismisses Bacardi's appeal from the decision of the Commissioner of the PTO which implemented the U.S. district court's decision vesting ownership of the Havana Club trademark registration in Cubaexport. *See Galleon, S.A. v. Rogan*, 44 Fed. Appx. 472 (Fed. Cir. 2002).

08/08/02 Rodriguez informs Freedman that Bacardi's Federal Circuit action was dismissed and that the cancellation proceeding will be resumed, and asks for further pressure on the PTO:

"Anything you can do at PTO's end, will be very helpful. The Governor told me recently when we were traveling back from London 'I hope we can do more' after I thanked him again for his letter to Rogan." (FOIA 0111.)

09/02/02 Jason Roe, Director Rogan's Chief of Staff, contacts (the recipient's identity was redacted by the PTO from the only copy available to respondent) and notes that Deputy Director Dudas "is going to take Bacardi mtg. tomorrow." (FOIA 0132.)

09/10/02 Respondent files motion pursuant to the Government in the Sunshine Act. (Respondent's 9/10 Motion.)

09/17/02

Deputy Director Dudas sends an e-mail to Meltzer concerning Bacardi, in which he says "I do not want to e-mail anything." (FOIA 0139.)